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IN THE

Supreme Court of the United States

October Term, 1974

No. 74-946

The Duplan Corporation, et al, *Petitioners*

v.

Moulinage et Retorderie De Chavanoz, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

John W. Malley
Lawrence A. Hymo
1801 K Street, N.W.
Washington, D.C. 20006
(202) 833-3000

McNeill Smith
P. O. Drawer G
Greensboro, North Carolina
27402
(919) 273-8263

Attorneys for Petitioners

Of Counsel

O. G. Calhoun
David L. Foster
Michael R. Abel

Press of Byron S. Adams Printing, Inc., Washington, D. C.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No.

THE DUPLAN CORPORATION, ET AL, *Petitioners*

v.

MOULINAGE ET RETORDERIE DE CHAVANOZ, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioners* respectfully pray that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Fourth Circuit entered in this proceeding on October 18, 1974.

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* The Duplan Corporation, Blanchard Yarn Company, Inc., Burlington Industries, Inc., Burkyarns, Inc., Dixie Yarns, Inc., Frank Ix & Sons Virginia Corp., Hemmerich Industries, Inc., Jonathan Logan, Inc., Lawrence Texturing Corp., Leon-Ferenbach, Inc., Madison Throwing Co., National Spinning Company, Inc., Olympia Industries, Inc., Reliable Silk Dyeing Co., Inc., Schwarzenbach-Huber Co., Spring-Tex, Inc., Texelastic Corporation, Texfi Industries, Inc., United Merchants & Manufacturers, Inc.

OPINIONS BELOW

The opinion of the Court of Appeals dated October 18, 1974 (A1) and its order dated December 20, 1974 denying a petition for rehearing (A12) have not yet been reported. The opinion of the District Court for the District of South Carolina dated February 5, 1974 (A14) is unreported. Other pertinent opinions of the courts below are reported at 487 F.2d 480 (A67) and at 61 F.R.D. 127 (A76).

JURISDICTION

The judgment of the Court of Appeals for the Fourth Circuit was entered on October 18, 1974. A petition for rehearing filed by one of the petitioners was denied on December 20, 1974. By order dated January 9, 1975, the time for filing this petition was extended to and including January 31, 1975. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. Under what circumstances, if any, are mental impressions, conclusions, opinions, or legal theories generated by an attorney or other representative of a party in connection with a prior terminated litigation discoverable in a subsequent litigation?

2. Whether mental impressions, conclusions, opinions or legal theories generated by an attorney or other representative of a party in connection with a prior terminated litigation are absolutely immune from discovery in a subsequent litigation under the decision of this Court in *Hickman* v. *Taylor*, 329 U.S. 495 (1947) and under Rule 26(b)(3) of the Federal Rules of Civil Procedure where the district court has expressly found that (1) the mental impressions, con-

clusions, opinions, or legal theories constitute key operative facts in a pending litigation, (2) the discovering parties have a substantial need for such facts, (3) the information contained in the documents is simply not available from any other source, and (4) the suppression of the documents will result in undue hardship, a frustration of justice and a suffocation of the truth.

3. Whether the protection of mental impressions, conclusions, opinions, or legal theories provided by Rule 26(b)(3) of the Federal Rules of Civil Procedure is so absolute that, as the Court of Appeals held, "no showing of relevance, substantial need or undue hardship should justify [their] compelled disclosure."

STATUTORY PROVISION INVOLVED

Federal Rules of Civil Procedure, Rule 26(b)(3)

Trial Preparation: Materials. Subject to the provisions of subdivision (b)(4) of this rule, a party may obtain discovery of documents and tangible things otherwise discoverable under subdivision (b)(1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by or for that other party's representative (including his attorney, consultant, surety, indemnitor, insurer, or agent) only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means. In ordering discovery of such materials when the required showing has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation.

STATEMENT OF THE CASE

This litigation consists of 37 separate patent and antitrust actions instituted in various federal forums but consolidated in the United States District Court for the District of South Carolina by transfers pursuant to 28 U.S.C. § 1404. Respondent is the owner of 22 patents relating to alleged improvements in false twist machinery and in the false twist process for imparting stretch or texture to synthetic yarn. Respondent has asserted these patents in this litigation in an effort to require petitioners to pay royalties for the use of texturing machines they bought from the American distributor of a French manufacturer licensed by respondent to make the machines.

Petitioners assert that the patents in suit are invalid, unenforceable, and not infringed. Petitioners also assert that respondent and others have violated the antitrust laws by enforcing a series and network of agreements whereunder American purchasers of texturing machinery were required, as a condition of purchase of the machinery, to execute a use license agreement and to pay continuing royalties to operate the machines even though the patent licensed was invalid or inapplicable.[1] Furthermore, petitioners assert that respondent combined and conspired with its principal competitor in the sale and licensing of false twist machines to insulate their respective patents and licensing programs from attack and to prevent the sale of royalty-free false twist machines in the United States. The jurisdiction of the district court is invoked under 15 U.S.C. § 15 and 28 U.S.C. §§ 1331, 1332, 1337 and 1338.

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[1] On motions for summary judgment, the district court has held that two of the patents on which petitioners were required to pay royalties are invalid (353 F.Supp. 826) and that twelve have not been infringed (Orders are unreported). Indeed, all six of the patents in the original package have been held to be inapplicable to the machines.

History of the Proceedings Below

During four years of discovery, respondent refused to produce many documents, which were submitted to the district court for examination *in camera*. The questions presented arise from two separate opinions of the court of appeals reversing rulings of the district court which made documents available after *in camera* inspections. The questions relate to the proper scope and application of the work product doctrine of *Hickman v. Taylor*, as codified by Rule 26(b)(3) of the Federal Rules of Civil Procedure, to materials prepared in connection with a prior terminated litigation. On May 9, 1973, in ordering the respondent to produce certain documents, the district court held "that (1) when a case in litigation is finally terminated; (2) by either a decision of the court or by settlement among the parties: (3) the work product privilege is also terminated: and (4) the work product of attorneys in the prior litigation is therefore subject to discovery in subsequent litigation." *The Duplan Corp. v. Deering Milliken, Inc.*, 61 F.R.D. 127, 135 (D.S.C. 1973). Respondent appealed. On October 23, 1973, the Fourth Circuit reversed the decision of the district court and held that upon termination of litigation the work product documents prepared incident thereto do not lose the immunity extended to them under Rule 26 (b)(3) and thus do not become freely discoverable in a subsequent litigation. *The Duplan Corp. v. Moulinage et Retorderie de Chavanoz*, 487 F.2d 480 (4th Cir. 1973).[2] In remanding to the district court,

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[2] The Fourth Circuit expressly acknowledged the existence of "divergent conclusions reached in similar cases":

"*See* Tobacco & Allied Stocks, Inc. v. Transamerica Corp., 16 F.R.D. 537 (D. Del. 1954); Hanover Shoe, Inc. v. United Shoe the Fourth Circuit stated:

> "Our decision will not in any way frustrate the ends of justice. If the party seeking discovery can demonstrate the substantial need and undue hardship specified in the Rule [26(b)(3)] and recognized in *Hickman*, the district court will order production. We think it appropriate and desirable that the district judge determine whether a party has made a showing sufficient to justify such an intrusion upon the privacy of an attorney's files."
>
> 487 F.2d at 485.

On remand, the district court again reviewed each of the documents at issue, and, by order dated February 5, 1974, held that petitioners had made the requisite showing and ordered certain of the documents to be produced and that certain others need not be produced.

Respondents then objected to production of certain documents, notwithstanding the showing, on the ground that they contained mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the prior terminated

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Machinery Corp., 207 F. Supp. 407 (M. D. Pa. 1962); Honeywell, Inc. v. Piper Aircraft Corp., 50 F.R.D. 117 (M. D. Pa. 1970) *Cf.* Insurance Company of North America v. Union Carbide Corp., 35 F.R.D. 520 (D. Colo. 1964); LaRocca v. State Farm Mutual Automobile Insurance Co., 47 F.R.D. 278 (W. D. Pa. 1969). *See also* Republic Gear Co. v. Borg Warner Corp., 381 F.2d 551, (2nd Cir. 1967). 487 F.2d at 484, n. 15.

For a discussion of the conflicting decisions on this issue, see Note, *Discovery of an Attorney's Work Product in Subsequent Litigation*, 1974 *Duke L. J.* 799.

litigation.[3] The District Court overruled that objection because it found that (1) the mental impressions, opinions, conclusions or legal theories contained in those documents themselves constitute relevant operative facts in the pending litigation, (2) those operative facts were unavailable from any other source, and (3) production of the documents is necessary to prevent a frustration of the ends of justice and suffocation of the truth. Respondent again appealed.

These findings were neither challenged by the respondent in the Court of Appeals nor questioned by the Court of Appeals which had the documents at issue before it.

The Fourth Circuit again reversed the decision of the district court and held that mental impressions, conclusions, opinions or legal theories of an attorney or other representative of a party concerning litigation are absolutely immune under *Hickman* v. *Taylor* and Rule 26(b)(3):

> "In our view, no showing of relevance, substantial need or undue hardship should justify compelled disclosure of an attorney's mental impressions, conclusions, opinions or legal theories. This is made clear by the Rule's use of the term 'shall' [protect] as opposed to 'may'." (A6)

REASONS FOR GRANTING THE WRIT

This petition presents a significant issue of federal discovery procedure. Specifically, it presents the question of the application and scope of the work product doctrine as defined by this Court in *Hickman* v.

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[3] None of the documents at issue was prepared in connection with the present litigation. Certain of the documents relate to prior litigation involving respondent and its principal competitor, the termination of which by various agreements is alleged by petitioners to constitute an antitrust violation. See page 16, *infra*.

Taylor and as codified by the 1970 amendments to the Federal Rules of Civil Procedure as Rule 26(b)(3). Federal district courts are presented with questions as to the scope and application of the work product doctrine on a recurring basis.[4] Review by this Court is thus necessary if the goal of uniformity of federal procedure is to be realized. See generally *Provident Bank and Trust Co.* v. *Patterson*, 390 U.S. 102 (1968); *Hanna* v. *Plumer*, 380 U.S. 460 (1965).

The court below has held that mental impressions, conclusions, opinions or legal theories of an attorney or other representative of a party concerning litigation are absolutely privileged in the sense that

> . . . no showing of relevance, substantial need or undue hardship should justify [their] compelled disclosure . . .[5]

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[4] In its opinion, the Fourth Circuit noted that "[c]ertainly, the most controversial problem in the discovery area is the extent to which a party may require divulgence of facts, legal contentions, or trial tactics gathered or devised by his adversary in preparation for litigation." (A 5)

[5] In the petition for rehearing filed by one of the petitioners, it was suggested that the decision below might be inconsistent with the Fourth Circuit's previous decision in *Union Camp Corp.* v. *Lewis*, 385 F.2d 143, 144-145 (1967):

> "The attorney-client privilege is withdrawn upon a *prima facie* showing that the lawyer's advice was designed to serve his client in the commission of a fraud or crime. United States v. Bob, 106 F.2d 37, 40 125 A.L.R. 502 (2d Cir. 1939), cert. denied.. 308 U.S. 589, 60 S.Ct. 115, 84 L.Ed. 493 (1939). See Clark v. United States, 289 U.S. 1, 15, 53 S.Ct. 465, 77 L.Ed. 993 (1933) (dictum); O'Rourke v. Darbishire, (1920) A.C. 581, 604, 614, 622, 631."

The Court of Appeals denied that petition. In view of the Fourth Circuit's denial of rehearing, respondent has argued in the district court that there is no exception to the work product immunity

Assertions of absolute privileges have not met with favor in this Court. See *United States* v. *Nixon*, — U.S. — (1974); *Clark* v. *United States*, 289 U.S. 1 (1933). Accordingly, we submit that this Court should consider whether *Hickman* and Rule 26(b)(3) require such an absolute protection from disclosure. Specifically, we submit that this petition should be granted for the following reasons:

1. To resolve conflict between the decision below and the decision of this Court in *Hickman* v. *Taylor:*
2. To resolve conflicting decisions regarding the scope and application of the work product doctrine and Rule 26(b)(3);
3. To resolve the confliet between the decision below and the policy underlying the federal discovery rules.

1. The Decision Below is Inconsistent with the Decision of This Court in Hickman v. Taylor

The court below noted that Rule 26(b)(3) of the Federal Rules of Civil Procedure is a codification of this Court's decision in *Hickman* v. *Taylor* and held that the policy considerations on which that decision is based require a rigid interpretation of the Rule

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afforded mental impressions, conclusions, opinions or legal theories even when such mental impressions, conclusions, opinions or legal theories were generated in furtherance of or reflect the commission of a tort, crime, or fraud. While petitioners do not agree with respondent's interpretation of the Fourth Circuit's denial of rehearing, the Court's attention is invited to that interpretation as an illustration of the far reaching and dangerous results that some might argue are required by the Fourth Circuit's decision. Another illustration is the respondent's recent argument in the district court that the protection afforded mental impressions, conclusions, opinions or legal theories cannot be waived even where there has been a failure to claim that protection.

such that an absolute privilege be afforded mental impressions, conclusions, opinions or legal theories of an attorney or other representative of a party concerning litigation. However, we submit that *Hickman*, when read in context, lends no support to this conclusion. As an analysis of that decision demonstrates, this Court held that there is only a qualified immunity for all work product materials.[6]

At issue in Hickman was the plaintiff's request that production be ordered of certain written statements obtained by the defendants' attorney in anticipation of the litigation. The written statements were based on interviews that the attorney had had with potential witnesses. The Court emphasized the absence of any showing of necessity for the requested materials:

> We are thus dealing with an attempt to secure the production of written statements and mental impressions contained in the files and the mind of the attorney Fortenbaugh [counsel for the de-

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[6] In *Hickman*, this Court recognized the distinction between the attorney-client privilege and the immunity afforded work product materials. 329 U.S. at 508. See *Radiant Burners, Inc.* v. *American Gas Association*, 320 F.2d 314, 323 (7th Cir.) cert. denied 375 U.S. 929 (1963) ("The attorneys' work product rule announced in Hickman . . . remains unimpaired and is something separate and apart from the attorney-client privilege."). In the decision below, the Fourth Circuit apparently did not focus on this distinction for it concluded that the decision of the district court would jeopardize communications of the kind traditionally protected by the attorney-client privilege. (A 10) No claim of attorney-client privilege was asserted for any of the documents at issue. Moreover, while Rule 26(b)(3) makes no distinction between attorneys and other representatives of a party, the court below analyzed *Hickman* and Rule 26(b)(3) only in terms of materials prepared by attorneys. It did not consider the implications of its rigid approach as applied to materials prepared by non-attorney representatives of a party. See p. 17, *infra*.

fendants] *without any showing of necessity or any indication or claim that denial of such production would unduly prejudice the preparation of petitioner's case or cause him any hardship or injustice.* For aught that appears, the essence of what petitioner seeks either has been revealed to him already through the interrogatories or is readily available to him direct from the witnesses for the asking.

* * *

> "Here is simply an attempt, *without purported necessity or justification*, to secure written statements, private memoranda and personal recollections prepared or formed by an adverse party's counsel in the course of his legal duties. As such, it falls outside the arena of discovery and contravenes the public policy underlying the orderly prosecution and defense of legal claims. Not even the most liberal of discovery theories can justify *unwarranted inquiries* into the files and the mental impressions of an attorney." 329 U.S. 509-10 (Emphasis added.)

The Court made clear however that if a sufficient showing of need and hardship could be shown, then discovery may properly be had:

> "Where relevant and non-privileged facts remain hidden in an attorney's file and where production of those facts is essential to the preparation of ones case, discovery may properly be had." 329 U.S. at 511.

The Court then turned to the discovery of oral statements made by witnesses which were in the form of the attorney's mental impressions or memoranda. As to these, the Court said:

> "But as to oral statements made by witnesses to Fortenbaugh, whether presently in the form of

> his mental impressions or memoranda, we do not believe that any showing of necessity can be made *under the circumstances of this case* so as to justify the production." 329 U.S. 512 (emphasis added).

However, the Court again indicated that there might be circumstances under which such mental impressions might become discoverable:

> "Petitioner's counsel frankly admits that he wants the oral statements only to help prepare himself to examine witnesses and to make sure that he has overlooked nothing. That is insufficient under the circumstances to permit him an exception to the policy underlying the privacy of Fortenbaugh's professional activities. If there should be a rare situation justifying production of these matters, petitioner's case is not of that type." 329 U.S. at 513.

In short, this Court in *Hickman* denied the production of written statements and mental impressions because the petitioner had failed to demonstrate "the denial of such production would unduly prejudice the preparation of his case or cause him any hardship or injustice." We submit, however, that this Court recognized that such written statements *and* mental impressions could be discovered when a proper showing has been made and in no way indicated that such statements or impressions were absolutely privileged and immune from discovery.[7] It is undisputed in the

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[7] Prior to the *Hickman* decision, the Advisory Committee on Rules of Civil Procedure had proposed the following amendment to the discovery rules:

> "The court *shall not order* the production or inspection of any part of the writing that reflects an attorney's mental impressions, conclusions, opinions, or legal theories . . . ." Re-

present case that the parties seeking discovery have established substantial need and undue hardship, and, moreover, the district court determined that to deny production of the documents requested would frustrate the demands of justice and result in a suffocation of the truth.

This Court in *Hickman* made clear that work product materials are not available on mere demand under the federal discovery rules. In *Hickman*, the Court adopted a balancing test whereunder an attorney's need for privacy in preparing for litigation is weighed against an adverse party's need for facts otherwise unavailable to it. Certiorari should be granted in this case to reaffirm that balancing test and to define its scope and proper application in cases involving mental impressions, conclusions, opinions or legal theories of an attorney or other representative of a party.

2. The Decision Below Is One of a Number of Conflicting Decisions of Lower Federal Courts as to the Proper Scope and Application of the Work Product Doctrine of Hickman v. Taylor and Rule 26(b)(3)

In addition to being inconsistent with prior decisions of this Court, the inflexible approach of the decision below is inconsistent with decisions in other courts. For example, the Seventh Circuit has held that an attorney's "notes and legal judgments are discoverable on a proper showing". *United States* v. *Brown*, 478

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port of Proposed Amendments by Advisory Committee on Rules of Civil Procedure (June, 1946), 5 F.R.D. 433, 458. (emphasis added).

The proposed amendment was not adopted. Significantly, Rule 26(b)(3), unlike the 1946 proposal, is not phrased in absolute terms. Nevertheless, in the decision below, the Fourth Circuit has in effect equated the second sentence of Rule 26(b)(3) with the 1946 proposal quoted above.

F.2d 1038, 1040 (7th Cir. 1973). In *Harper and Row v. Decker,* 423 F.2d 487, 492 (7th Cir. 1970) *aff'd per curiam by an equally divided court,* 400 U.S. 348 (1971), the court refused to adopt an inflexible approach to discovery of documents containing mental impressions, etc. but stated, "Of course, the less the lawyers' 'mental processes' are involved, the less will be the burden to show good cause." On the other hand, in the context of criminal grand jury proceedings, the Eighth Circuit has held that mental impressions, conclusions, opinions or legal theories of an attorney are absolutely privileged under *Hickman. In re Grand Jury Proceedings,* 473 F.2d 840 (8th Cir. 1973).

Federal district courts are similarly in conflict on this question and the conflicting decisions were noted by the Fourth Circuit in the opinion below. (A8) In addition to those decisions, we invite the Court's attention to the recent decision in *Xerox Corporation v. International Business Machines Corporation,* 64 F.R.D. 367 (S.D.N.Y.) 1974). In that case, Judge Edelstein rejected the rigid absolute immunity approach, and said:

> "It is therefore apparent that the basic thrust of *Hickman* and its progeny is that documents containing the work product of attorneys which contain the attorney's thoughts, impressions, views, strategy, conclusions, and other similar information produced by the attorney in anticipation of litigation are to be protected when feasible, but not at the expense of hiding the non-privileged facts from adversaries or the Court.
>
> * * * * *
>
> A party should not be allowed to conceal critical, non-privileged discoverable information, which is uniquely within the knowledge of the party and

> which is not obtainable from any other source, simply by imparting the information to its attorney and then attempting to hide behind the work product doctrine, after the party fails to remember the information. Thus, the Court believes that the information can be turned over to the requesting party while at the same time protecting, as best possible, the attorney's mental impressions, conclusions, opinions and legal theories, by having the Court review the documents and excise, if feasible, privileged information." 64 F.R.D. at 381-382.

The conflicting decisions by lower federal courts constitute a threat to the goal of uniformity of federal procedure sought by the Federal Rules of Civil Procedure. Review of the decision below by this Court is necessary to remove that threat.

3. The Decision Below Conflicts with the Underlying Purpose and Policy of the Federal Discovery Rules

It is fundamental that the underlying policy and purpose of the federal discovery rules is to provide means by which litigants can obtain disclosure of all relevant facts. Relevant to the antitrust issues in this case are respondent's knowledge, intent and good faith. Such matters are involved, for example, in connection with petitioners' allegations that it was improper for respondent to require petitioners to take a patent license under a package of patents known by respondent to be invalid and/or inapplicable to the licensed machines. The district court's descriptions of the documents reveal that 18 of them contain operative facts relating to respondent's knowledge of the scope of its patents and the prior art pertaining to those patents. The district court found that these operative facts are not available to petitioners from any other source,[8] and, thus, unless production of the documents in question is ordered, these facts will remain hidden and the truth of the matter may be suffocated.

Also at issue in this case is the presence or absence of good faith when respondent entered into an agreement in 1964 with its principal competitor to insulate their respective patents and licensing programs from attack and to prevent the sale of royalty free false twist machines thereby assuring that "use" royalties would be charged on all machines available to petitioners and otherwise unlawfully restraining and monopolizing trade and commerce in those machines and related technology. Petitioners charge that this conduct violates Sections 1 and 2 of the Sherman Act (15 U.S.C. §§ 1 and 2). Since this agreement was in the form of settlement of then-pending litigation, the presence or absence of good faith on the part of respondent and its competitor in entering into that agreement is an issue in this case. See *Standard Oil Company* v. *United States,* 283 U.S. 163 (1931). The district court found that two of the documents which it ordered to be produced will reveal respondent's motive and intent in entering into that agreement. Without those documents, such evidence will remain hidden.

Significantly, this case cannot be construed as an attempt by a slothful advocate to deprive his opponent of an adversarial advantage gained by the latter's diligence. None of the documents sought provide any information bearing upon the efforts of counsel in this case, or upon their mental impressions concerning this litigation. However, the fact that in the past, respondent and its agents had knowledge or notice of, for example, the infirmities of their patent position is a directly relevant item of evidence of greatest significance. To deny absolutely discovery of the mental processes generated in the past litigation which manifest such infirmities is to deprive petitioners of access to what is logically a direct source of evidence.

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[8] The district court stated:

> "There can be no doubt that the [petitioners] have diligently pursued every avenue to discover the true facts. Their appeal to this court for these documents does not represent an avoidance of any responsibility to pursue evidence. The problem facing the [petitioners] is a very practical one: The information contained in the documents is simply not available from any other source, irrespective of the degree of hardship they may experience." (A 19)

It is also significant that most of the documents in question were not prepared by an attorney but by an agent of the respondent, who is described by the district court as "one of the principal architects of the patent licensing system and the alleged illegal 1964 patent settlement agreements . . . ." (A20) This agent died before his deposition could be taken by the petitioners in this case.[9] Therefore, the documents in question are the only source from which the petitioners can hope to obtain direct evidence of the actual motive and intent of respondent as revealed by its "principal architect."

The foregoing brief summary of the facts involved in the litigation at bar reveal that the effect of the Fourth Circuit's decision will be to permit respondent to hide key operative facts that are relevant to an informed decision on important questions of antitrust law. As the district court has found, the failure to require production of the documents in question will result in a suffocation of the truth. We submit that such a suffocation of the truth is not required under *Hickman* v. *Taylor* or under Rule 26(b)(3). The disclosure of mental impressions, conclusions, opinions or legal theories under the circumstances of this case will not, as the Fourth Circuit seems to fear, undermine the integrity of the legal profession. As the district court noted in its opinion:

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[9] If his deposition had been taken, petitioners could have questioned him with respect to the scope of the patents in suit, his knowledge of pertinent prior art, and respondent's motive and intent in entering into the settlement agreement.

> "An attorney, in conscientiously carrying out his duty as an officer of the Court, should have no fear that his good faith efforts will not be recognized for what they are. Likewise, a lawyer, advising his client in an antitrust conspiracy or in a scheme to defraud the patent office should not be allowed to enjoy the smug self-satisfaction that his legal talents are being used as a tool for the perpetration of a crime or a civil wrong, and, because of the work product rule, are forever protected against discovery. The denial of production of such documents from a prior terminated lawsuit would result in the suffocation of truth and the frustration of justice in the subsequent lawsuit."

The District Court therefore found that there were circumstances present in this case which create a need for disclosure which transcends the important policy considerations ordinarily justifying protecting the privacy of mental impressions, etc. In directing production of the documents in such circumstances, the district court's analysis is consistent with that recently articulated by this Court in *United States* v. *Nixon:*

> "In this case we must weigh the importance of the general privilege of confidentiality of presidential communications in performance of his responsibilities against the inroads of such a privilege on the fair administration of criminal justice. The interest in preserving confidentiality is

> weighty indeed and entitled to great respect. However, we cannot conclude that advisers will be moved to temper the candor of their remarks by the infrequent occasions of disclosure because of the possibility that such conversations will be called for in the context of a criminal prosecution."

Petitioners respectfully submit that the district court's decision should not have been overturned because of an inflexible rule of absolute privilege.

CONCLUSION

For the foregoing reasons, petitioners pray that their petition for a writ of certiorari be granted.

Respectfully submitted,

JOHN W. MALLEY
LAWRENCE A. HYMO
CUSHMAN, DARBY & CUSHMAN
1801 K Street, N.W.
Washington, D.C. 20006
(202) 833-3000

MCNEILL SMITH
SMITH, MOORE, SMITH, SCHELL & HUNTER
P. O. Drawer G
Greensboro, North Carolina 27402
(919) 273-8263

Attorneys for Petitioners

Of Counsel

O. G. CALHOUN
DAVID L. FOSTER
MICHAEL R. ABEL

January 31, 1975

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UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 74-1221

THE DUPLAN CORPORATION, *Appellee*

v.

MOULINAGE ET RETORDERIE DE CHAVANOZ, *Appellant*

DEERING MILLIKEN, INC., DEERING MILLIKEN RESEARCH CORPORATION, ATELIERS ROANNAIS DE CONSTRUCTIONS TEXTILES, and ARTC, INC., *Defendants*

OPINION

Appeal from the United States District Court for the District of South Carolina, at Spartanburg. Robert W. Hemphill, District Judge.

Argued April 4, 1974 Decided October 18, 1974

Before ADAMS,* FIELD and WIDENER, *Circuit Judges.*

*United States Court of Appeals for the Third Circuit; sitting by designation.

Jay H. Topkis (Butler, Means, Evins and Browne and Paul, Weiss, Rifkind, Wharton and Garrison on brief) for Appellant Chavanoz; Fletcher C. Mann (Allan Trumbull, O. G. Calhoun, John J. Barnhardt, III, Michael R. Abel and Lawrence A. Humo on brief) for Appellee Duplan Corporation.

WIDENER, Circuit Judge:

This case presents the question whether an attorney's opinion work product material developed in prior terminated litigation may properly become the subject of discovery in connection with subsequent litigation. The issue involves the work product doctrine of *Hickman* v. *Taylor*, 329 U.S. 495 (1974) [*sic*], and the scope of the protection afforded a lawyer's "mental impressions, conclusions, opinions, or legal theories" by Rule 26(b)(3) of the Federal Rules of Civil Procedure.[1]

We hold that such opinion work product material, as distinguished from material not containing mental impressions, conclusions, opinions, or legal theories, is immune from discovery although the litigation in which it was developed has been terminated. Thus, for reasons which follow, we vacate the judgment of the district court and remand.

This patent-antitrust litigation presently consists of 37 cases which have been consolidated in the district court. Duplan Corporation (the throwsters) brought this suit charging Moulinage et Retourderie de Chavanoz (Chavanoz) and others with violating Sections 1 and 2 of the Sherman Act by denying the throwsters a free and open market for the purchase of unlicensed royalty-free false twist machines. Claiming patent misuse and inequitable conduct on the part of Chavanoz in dealing with the United States Patent Office, the throwsters also seek a declaratory judgment that 21 patents owned by Chavanoz are invalid, unenforceable and not infringed.

In this context, the throwsters seek discovery of work product material developed by Chavanoz's attorneys and others relating to 1964 settlement agreements with Leesona Corporation,[2] and also relating to knowledge by Chavanoz of the state of the prior art involved in its patented process.[3]

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[1] Rule 26(b)(3), F.R.C.P., reads as follows:

"(3) *Trial Preparation: Materials.*—Subject to the provisions of subdivision (b)(4) of this rule, a party may obtain discovery of documents and tangible things otherwise discoverable under subdivision (b)(1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by or for that other party's representative (including his attorney, consultant, surety, indemnitor, insurer, or agent) only upon a showing that the party seeking discovery has substantial need of the materials in preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means. In ordering discovery of such materials when the required showing has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation."

In an earlier appeal, *Duplan Corp. v. Moulinage et Retourderie de Chavanoz*, 487 F.2d 480 (4th Cir. 1973), we held, "upon the narrow question whether upon termination of litigation the work product documents prepared incident thereto lose the qualified immunity extended to them under Rule 26(b)(3), Federal Rules of Civil Procedure," they do not automatically "become freely discoverable in subsequent and unrelated litigation."[4] Because we were not then confronted with any claim relating to opinion work product, we dealt solely with the first sentence of Rule 26(b)(3) as applied to factual materials contained in an attorney's files.

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[2] In the early 1960's, Leesona Corporation claimed in a series of lawsuits that United States patents which it owned were infringed by the sale and operation of machines manufactured by a licensee of Chavanoz. These lawsuits were settled in 1964 by agreement between Leesona and Chavanoz.

[3] "In particular, the throwsters request that documents should be produced dealing with the following matters:

> (a) *Patent Procurement.* What knowledge did Chavanoz possess about prior 'false twist' art at the time that it filed and prosecuted each patent application in the U.S. Patent Office? Did the French patent agent, Leo Soep, disclose to the U.S. Patent Office the pertinent facts he knew about the prior art? Did the American patent attorneys Armitage and Mueller disclose to Chavanoz or to the U.S. Patent Office the pertinent facts they knew about the prior art? Were representations to the appropriate Patent Office officials accurate and candid?. . . .
>
> (b) *Patent Enforcement.* When the patent owner and/or the exclusive U.S. use-licensee filed infringement suits against the defaulting sublicensee throwsters, did they know or have reason to know that they were attempting to enforce invalid or inapplicable patents?. . . .
>
> (c) *Termination of Patent Litigation.* . . . what facts were known by the Chavanoz/Deering Milliken Research Corporation Group about the alleged invalidity and inapplicability of Chavanoz' patents when entering the 1964 agreements with the Leesona/Permatwist Group? [What evidence is there] . . . about the alleged invalidity and inapplicability of Leesona patents . . . [involved in the same] settlement agreements . . ."
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> [?] Opinion of district court, p. 4-5.

Upon remand, the district court separately reviewed the documents in question, and in an order dated December 21, 1973 directed Chavanoz to produce 105 of them. Fifty-eight of these 105 documents have been produced; the remaining 47 were the subject of a motion for reconsideration by Chavanoz. As to these, Chavanoz claimed they were protected from discovery under Rule 26(b)(3) since they contained mental impressions, conclusions, opinions, and legal theories of attorneys and other representatives of Chavanoz prepared in anticipation of litigation or for trial. Nevertheless, on February 5, 1974, the district court ordered production of 22 of the 47 documents, finding that as to each of these the throwsters had demonstrated "substantial need" and "undue hardship." And although it acknowledged that Rule 26(b)(3) accords an absolute privilege during pending litigation to opinion work product materials prepared incident thereto, the court held that immunity ceases and the protection becomes only "qualified" once the litigation for which they were prepared terminates.

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[4] In so holding, we stated that "the legal profession and the interests of the public are better served by recognizing the qualified immunity of work product materials in a subsequent case, as well as that in which they were prepared. . . ." 487 F.2d at 484. Then, in remanding to the district court, we stated:

> "Our decision will not in any way frustrate the ends of justice. If the party seeking discovery can demonstrate the substantial need and undue hardship specified in the Rule and recognized in *Hickman*, the District Court will order production. We think it appropriate and desirable that the district judge determine whether a party has made a showing sufficient to justify such an intrusion upon the privacy of an attorney's files." 487 F.2d at 485.

Certainly, the most controversial problem in the discovery area is the extent to which a party may require divulgence of facts, legal contentions, or trial tactics gathered or devised by his adversary in preparation for litigation.[5] The Supreme Court in *Hickman* v. *Taylor*, 329 U.S. 495 (1945), granted certain of these materials a qualified immunity. There the defendant's counsel had personally secured oral and written statements from witnesses in preparation for pending litigation. The plaintiff's counsel, in order to prepare for his own examination of these witnesses, sought copies of these signed written statements and detailed resumes of the oral statements. Characterizing these materials as the "work product" of the lawyer the court held that without a showing of special need they were privileged from discovery.

In the federal courts from 1946 to 1970, the scope of *Hickman* and the work product doctrine was left to adjudication on a case by case basis. The decisions were often conflicting, and we have previously quoted one court's remark that *Hickman* v. *Taylor* had opened a Pandora's Box.[6] After numerous abortive attempts to reconcile the Rules with *Hickman*, the Advisory Committee on Civil Rules finally agreed upon a draft of Rule 26(b)(3) of the Federal Rules of Civil Procedure. As adopted by the Supreme Court in 1970, Rule 26(b)(3) contains these special provisions for trial preparation materials:

> "Subject to the provisions of subdivision (b)(4) of this rule, a party may obtain discovery of documents

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[5] See, e.g., 4 *Moore's Federal Practice* ¶ 26.63-64 (1974); 2A Barron & Holtzoff, *Federal Practice and Procedure* § 652 (Wright ed. 1961); 8 Wright & Miller, *Federal Practice and Procedure* §§ 2021-27 (1970); Advisory Committee Note to the 1970 amendments of Rule 26(b)(3), 48 F.R.D. 499 (1970); Freund, *Work Product*, 45 F.R.D. 479 (1968); Note, *Developments in the Law—Discovery*, 74 Harv. L. Rev. 940, 1027 (1961).

[6] *Viront* v. *Wheeling & L. E. Ry. Co.*, 10 F.R.D. 45, 47 (D.C. Ohio 1950).

> and tangible things otherwise discoverable under subdivision (b)(1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by or for that other party's representative (including his attorney, consultant, surety, indemnitor, insurer, or agent) only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means. In ordering discovery of such materials when the required showing has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation."

The first sentence grants a qualified immunity to "documents and tangible things . . . prepared in anticipation of litigation." The second sentence, however, provides "in ordering discovery of *such materials* the court *shall* protect against disclosure of the mental impressions. . . ." [Emphasis added] By their terms, the two sentences are complementary. Thus, it is apparent that the clear command of the second sentence to "protect against disclosure" applies to all the materials referred to in the first sentence. In our view, no showing of relevance, substantial need or undue hardship should justify compelled disclosure of an attorney's mental impressions, conclusions, opinions or legal theories. This is made clear by the Rule's use of the term "shall" as opposed to 'may."

The district court, however, reasoned that what was a mental impression, opinion, conclusion, or legal theory, although absolutely protected during the pendency of a lawsuit, may change to an "operative fact" in a subsequent case once the earlier lawsuit is terminated. And should this happen, upon a proper showing of substantial need and undue hardship, the district court held that it might in its discretion order the production of opinions and conclusions where the denial of such production would frustrate the demands of justice and result in suffocation of the truth.

The district court then devised an operative fact exception to the otherwise absolute immunity accorded opinion work product by Rule 26(b)(3).[7] In our view, this construction fails to comport with the policies underlying *Hickman* v. *Taylor* and Rule 26(b)(3).

It seems clear from the whole tenor of the *Hickman* opinion that the court was concerned with protecting the thought processes of lawyers and thus the very adversary system. As Justice Murphy stated in this now classic passage from *Hickman:*

> "Historically, a lawyer is an officer of the court and is bound to work for the advancement of justice while faithfully protecting the rightful interests of his clients. In performing his various duties, however, it is essential that a lawyer work with a certain degree of privacy, free from unnecessary intrusion by opposing parties and their counsel. Proper preparation of a client's case demands that he assemble information, sift what he considers to be the relevant from the irrelevant facts, prepare his legal theories and plan his strategy without undue needless interference. That is the historical and the necessary way in which lawyers act within the framework of our system of

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[7] Because it was contended here that the 1964 settlement agreements between Leesona Corporation and the patent owner, Chavanoz, were in fact an antitrust conspiracy, the district court ordered production of certain opinion work product materials since "the mental impressions, opinions, conclusions, and legal theories of the attorney in the prior litigation are now operative facts as to the motive and intent of the parties at the time of the settlement." District court opinion at p. 16. As to the contentions that fraud was practiced on the U. S. Patent Office, the court ordered production of similar materials since "the mental impressions, opinions, conclusions, and legal theories of the attorneys prosecuting the patent applications for Chavanoz are now operative facts as to the motive and intent of the patent owner in its dealing with the Patent Office." District court opinion at p. 16.

> jurisprudence to promote justice and to protect their client's interests." 329 U.S. at 510-511.

Should an advocate's thoughts, theories, opinions, and impressions, collected and developed during pending litigation, become discoverable in connection with later litigation because they are thought to be relevant, our adversary system would clearly suffer. Its foundation would be undermined. And in our view, the fears articulated by the *Hickman* court should apply here with equal force:

> "Were such materials open to opposing counsel on mere demand, much of what is now put down in writing would remain unwritten. An attorney's thoughts, heretofore inviolate, would not be his own. Inefficiency, unfairness and sharp practices would inevitably develop in the giving of legal advice and in the preparation of cases for trial. The effect on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served." 329 U.S. at 511.

In reaching our decision, we have considered with some care those cases in which courts have heretofore permitted discovery of lawyers' opinion work product.[8] See, e.g., *United States* v. *Brown*, 478 F.2d 1038 (7th Cir. 1973); *Merrin Jewelry Co.* v. *St. Paul Fire and Marine Insurance*

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[8] Not all of these cases can be distinguished, certainly. But we agree with Wright & Miller's observation that not every case decided prior to July, 1970 remains authoritative. "On some points the new rule resolves conflicts in the cases. Some decisions in the past may be improper applications of the doctrine announced in *Hickman* and now put into a rule. Thus, pre-1970 cases must be resorted to with discrimination and care. . . ." 8 Wright & Miller, *Federal Practice and Procedure, Civil* § 2023, at 193 (1970).

The following cases, decided since the 1970 amendments to Rule 26(b)(3), refused to allow discovery of opinion work product: *Smedley* v. *Travelers Ins. Co.*, 53 F.R.D. 591 (D. N.H. 1971) (rule referred to); *Crocker* v. *United States*, 51 F.R.D. 155 (N.D. Miss. 1970) (rule not referred to, but the court used the phrase "'mental impressions, conclusions, and legal theories).

Co., 49 F.R.D. 54 (S.D.N.Y. 1970); *Bourget v. Government Employees Ins. Co.*, 48 F.R.D. 29 (D. Conn. 1969); *O'Boyle v. Life Ins. Co. of North America*, 299 F.Supp. 704 (W.D. Mo. 1969); *Kearney & Trecker Corp. v. Giddings & Lewis, Inc.*, 296 F.Supp. 979 (E.D. Wis. 1969); *Kirkland v. Morton Salt Co.*, 46 F.R.D. 28 (N.D Ga. 1968). But none of these cases were decided under Rule 26 (b)(3), and most of them may be additionally distinguished on their facts from the situation before us here. In such instances, in those cases, however, where the courts concerned treated attorneys' opinion work product as having only a qualified immunity which was not then honored, we believe the results were incompatible with *Hickman v. Taylor* and certainly the subsequent Rule 26(b)(3) which encompasses the protection termed "absolute" by Wright & Miller in 8 *Federal Practice and Procedure, Civil*, 1970, p. 193.

The throwsters rely upon *Bird v. Penn Central Co.*, 17 F.R.Serv. 2d 1402 (E.D. Pa. 1973), where the court ordered production of attorneys' memoranda containing mental impressions and legal conclusions relating to the sufficiency of a rescission claim upon the requisite showing. The *Bird* holding, however, merely applied the established rule that a party cannot affirmatively assert reliance upon an attorney's advice and then refuse to disclose such advice. See 8 Wigmore, *Evidence* § 2327 (McNaughten ed. 1961). And in *International Tel. & Tel. Corp. v. United Tel. Co.*, 60 F.R.D. 177 (M.D. Fla. 1973), which the throwsters also rely upon, the court noted that mental impressions and legal theories are "entitled to greater protection than other" trial preparation materials, but refused to order their disclosure despite a strong showing of substantial need and undue hardship, the materials being "almost absolutely unavailable otherwise"

We know that our adversary system of justice relies heavily on the attorneys for its very functioning. And in many or even most cases, nothing less than the lawyer's very best is adequate. In every instance in which an attorney is consulted (even confining our remarks to the words of the Rule) "in anticipation of litigation" he must be free to give his candid, dispassionate opinion, and equally free to record it and his mental impresssions and conclusions. No other rule is compatible with the interests of justice. The client seeking the opinion must be similarly uninhibited. So the attorney may not properly perform, and the client may not seek his due, if candid professional opinions prepared for a client in one case may be used against the client in subsequent litigation in the context sought here. The restriction on the attorney in giving advice, and the inhibition on the client in seeking it, is simply not compatible with our adversary system.

It is true that litigation is no longer a game of hide and seek, and also true that justice is to a large extent equated with truth. But if attorneys may not freely and privately express and record mental impressions, opinions, conclusions, and legal theories, in writing, and clients may not freely seek them, then there is justice for no one, and truth, instead of being more readily ascertainable, will become lost in the murky recesses of the memory in the minds of men, who, after all, are human and subject to the human frailty of rationalization. Cf. *Hickman*, p. 511.

We thus adhere to and follow our holding in *Duplan Corp. v. Moulinage et Retorderie de Chavanoz*, 487 F.2d 480 (4th Cir. 1973) (that the immunity extended to work product may extend in time beyond the litigation at hand) and hold here that the immunity extended to attorneys' mental impressions, conclusions, opinions, or legal theories by the last sentence of FRCP 26(b)(3) does not expire once the litigation for which they are prepared has been concluded.[9]

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[9] See 8 *Federal Practice and Procedure*, Civil, Wright & Miller (1970), p. 201.

The documents immediately in question here are described by the parties as twenty-two in number. They say twenty-five documents were not ordered to be produced. Any questions with relation to documents not ordered to be produced are moot.[10] Although all of the documents containing opinion work product is not that of attorneys, all have been treated by the parties and the district court as being that of attorneys "or other representative[s] of a party." And it is clear the parties agree that the district court treated all of the documents here in question as not discoverable unless the opinion work product immunity ceases with the litigation for which prepared: ". . . this court may in its discretion order the production of opinions and conclusions. . . ." District court opinion, p. 19.

We are mindful that certain documents may contain both discoverable material and non-discoverable material. On remand, the district court may, providing the other prerequisites for discovery have been met, excise from such documents the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative, and order the balance of the documents to be produced. See Note of the *Advisory Committee*, etc., 48 F.R.D. 457, 502; 8 *Federal Practice and Procedure, Civil*, Wright and Miller (1970), p. 231-2. The district court also may require Chavanoz to abstract such documents for turning over to the throwsters, or may itself abstract the documents, in either case taking care to protect against disclosure of mental impressions, conclusions, opinion, or legal theories as directed by the last sentence of FRCP 26(b)(3).

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[10] Appendix C to the opinion of the district court lists 48 documents, 24 to be produced and 24 not to be produced. The discrepancy in numbers may be due to document Cat. 10, No. 85, which the court ordered produced *sua sponte*. Two of the twenty-four documents ordered to be produced were found by the district court not to come within the rule. This is pointed out in the throwsters' brief and not taken issue with in the reply brief of Chavanoz. The twenty-two documents to which this opinion applies, then, are the twenty-four documents ordered to be produced by Appendix C of the opinion of the district court less the two held not to come within the rule, numbers Cat. 10, No. 397, and Cat. 10, No. 574.

REVERSED AND REMANDED

(Caption Omitted in Printing)

ORDER

We have considered the petition for rehearing and are of opinion it is without merit.

During the pendency of the petition for rehearing, we have been advised that the documents to which this opinion applies are 21 in number, rather than 22, and that there may have been a typographical error in the opinion of the district court.

We are of opinion such typographical errors may be corrected by order of the district court under FRCP 60.

It is accordingly Adjudged and Ordered as follows:

I

The petition for rehearing shall be, and it hereby is, denied.

II

Footnote 10 in the opinion of the court filed October 18, 1974 is rewritten to read as follows:

> 10. Appendix C to the opinion of the district court lists 48 documents, 23 to be produced and 25 not to be produced. The discrepancy in numbers may be due to document Cat. 10, No. 85, which the court ordered produced *sua sponte*. In all events, only twenty-one documents are in dispute here, rather than twenty-two, for two of the twenty-three documents ordered to be

produced were found by the district court not to come within the rule. This is pointed out in the throwsters' brief and not taken issue with in the reply brief of Chavanoz. The twenty-one documents to which this opinion applies, which include the document taken up *sua sponte*, then, are the twenty-three documents ordered to be produced by Appendix C of the opinion of the district court less the two held not to come within the rule, numbers Cat. 10, No. 397, and Cat. 10, No. 574.

With the concurrences of Judge Adams* and Judge Field.

/s/ H. E. Widener, Jr.
For the Court

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* United States Court of Appeals for the Third Circuit; sitting by designation.

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF SOUTH CAROLINA
SPARTANBURG DIVISION

THE DUPLAN CORPORATION, *Plaintiff*,
v.
DEERING MILLIKEN, INC., DEERING MILLIKEN RESEARCH CORPORATION, MOULINAGE ET RETORDERIE DE CHAVANOZ, ATELIERS ROANNAIS DE CONSTRUCTIONS TEXTILES, and ARCT, INC., *Defendants.*

CONSOLIDATED CIVIL ACTION
No. 71-306

ORDER

(Filed February 5, 1974)

ON MOTION FOR RECONSIDERATION OF PREVIOUS ORDER FOR PRODUCTION OF DOCUMENTS, UNDER FEDERAL RULES OF CIVIL PROCEDURE 34(a)(1) AND 26(b)(3).

PRODUCTION OF DOCUMENTS, UNDER FEDERAL RULES OF CIVIL PROCEDURE 34(a)(1) [1] AND 26(b)(3) [2]

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[1] F.R.Civ. P. 34(a)(1) provides: Production of Documents and Things and Entry Upon Land For Inspection and Other Purposes.

(a) Scope. Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on his behalf, to inspect and copy, any designated documents (including writings, drawings, graphs, charts, photographs, phono-records, and other data compilations from which information can be obtained, translated, if necessary, by the respondent through detection devices into reasonably usable form), or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served.

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[2] F.R.Civ.P. 26(b)(3) provides: General Provisions Governing Discovery.

(b) Scope of Discovery. Unless otherwise limited by order of the court in accordance with these rules, the scope of discovery is as follows:

(3) Trial Preparation: Materials. Subject to the provisions of subdivision (b) (4) of this rule, a party may obtain discovery of

By its order, dated May 9, 1973, the court directed the laintiff patent owner, Chavanoz, to turn over to the deendant licensees (hereinafter designated as the Throwters) certain work-product documents from prior terminted litigations unrelated to the pending litigation. Recogizing that their discoverability under Rule 26(b) (3) creted a difficult question and that guidance in this area was eeded for the future, the court encouraged Chavanoz to ppeal and certified the order in accordance with 28 U.S.C. 1292(b). On appeal, the Court of Appeals for the ourth Circuit on October 23, 1973, held, "upon the narrow uestion whether upon the termination of litigation the vork product documents prepared incident thereto lose he *qualified* immunity extended to them under Rule 26(b) 3), Federal Rules of Civil Procedure," they do not autonatically "become freely discoverable in subsequent and nrelated litigation." Slip op., at 2. (Emphasis added, ootnote omitted.) The Court of Appeals did not, however, lose its opinon with this holding. Its opinion recognized hat sometimes there is a need for production of so-called vork product documents, stating:

> Our decision will not in any way frustrate the ends of justice. If the party seeking discovery can demonstrate the substantial need and undue hardship specified in the Rule [26(b)(3)] and recognized in Hickman [v. Taylor, 329 U.S. 495 (1947)], the district

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locuments and tangible things otherwise discoverable under sublivision (b)(1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by or for that other party's representative (including his attorney, consultant, surety, indemnitor, insurer, or agent) only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means. In ordering discovery of such materials when the required showing has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation.

> court will order production. We think it appropriate and desirable that the district judge determine whether a party has made a showing sufficient to justify such an intrusion upon the privacy of an attorney's files. Slip op., at 15. (Footnotes omitted).

Pursuant thereto, the court directed both parties to submit a memorandum of law on "substantial need" and "undue hardship" within the meaning of Rule 26(b)(3). This court thereafter convened for the in camera inspection, in accordance with the directions of the Fourth Circuit, of the 154 documents, of 703 presented, for which a work product privilege as to prior terminated litigation was claimed. The court has decided what would constitute a sufficient showing of substantial need and undue hardship. It has endeavored to analyze each document separately and, by order of December 21, 1973, directed production of 105 documents and honored the privilege for 49 other documents. Plaintiff moved for reconsideration of the ruling as to 47 documents, and oral arguments were heard on January 4, 1974. This order supersedes the order dated December 21, 1973. The prior order stands as the uncontested analysis of the remaining 107 documents.

In Appendix B, the court has set forth a list of twelve categories or reasons asserted by the Throwsters as to why the work product immunity fails. In Appendix C, the court has listed each of the documents that it carefully re-evaluated, with notations and comments as to each with the reasons for this court's reconsideration either to order or not to order production.

SUBSTANTIAL NEED AND UNDUE HARDSHIP

Before the amendment of Rule 34 in 1970, a showing of "good cause" had to be made before a court would order the production of documents used by an attorney in preparation of a prior case in which proceedings were terminated at the time the request for production was made.

With the amendment of Rule 26, also in 1970, the accompanying Notes of the Advisory Committee to the Supreme Court on Rules state:

> The rules are amended by eliminating the general requirement of "good cause" from Rule 34 but retaining a requirement of a special showing for trial preparation materials in this subdivision. The required showing is expressed, not in terms of "good cause" whose generality has tended to encourage confusion and controversy, but in terms of the elements of the special showing to be made: substantial need of the materials in the preparation of the case and inability without undue hardship to obtain the substantial equivalent of the materials by other means. 28 U.S.C.A., Fed. R. Civ. P. 24-33, at 157 (1970).

Whether or not this "new" standard of substantial need and undue hardship is substantively or only semantically different from the old standard of good cause, this court feels that it can rely on the case law under the old standard of good cause as at least persuasive authority to determine what will constitute a sufficient showing under the new standard of substantial need and undue hardship.

A. SUBSTANTIAL NEED.

While the work product question was on appeal, the parties submitted, on August 6, 1973, a statement of their antitrust and patent misuse contentions which substantially clarifies the background against which the need for production of these documents are considered. These contentions appear in Appendix A. The Throwsters filed ten specific contentions and indicated the type of evidence which they will present to sustain them. Basic to the Throwster contentions 4, 5, 6, 7, 8 and 9 are the operative facts of Chavanoz' and the other plaintiffs' (DMRC, DMI, ARCT-France, ARCT, Inc.) knowledge, intent and good faith. The Throwsters contend that any relevant document which will disclose facts bearing on Chavanoz/

DMRC's knowledge, intent or good faith, or leading to other admissible documents which will do so, should be produced. In particular, Throwsters request that documents should be produced on the following:

1. *Patent procurement.* What knowledge did Chavanoz possess about prior "false twist" art at the time it filed and prosecuted each patent application in the U.S. Patent Office? Did the French patent agent Soep disclose to the U.S. Patent Office the pertinent facts he knew about the prior art? Did the American patent attorneys Armitage and Mueller disclose to Chavanoz or to the U.S. Patent Office the pertinent facts they knew about the prior art? Were representations to the appropriate Patent Office officials accurate and candid? Evidence on these subjects, wherever it may be, is requested to be produced. *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 808, 818 (1945); *Walker* v. *Food Machinery Corp.*, 382 U.S. 172 (1965).

2. *Patent enforcement.* When the patent owner and/or the exclusive U.S. use-licensee filed infringement suits against the defaulting sub-licensee Throwsters, did they know or have reason to know that they were attempting to enforce invalid or inapplicable patents? The same question arises with respect to the 1964 patent litigation between the Leesona/Permatwist Group and the Chavanoz/DMRC Group. That infringement suits can be conspiratorial acts is well established. *United States* v. *Singer Mfg. Co.*, 374 U.S. 174 (1963). Were the enforcement efforts part of a continuing combination and conspiracy so that the infringement suits were merely conspiratorial acts?

3. *Termination of patent litigation.* A key operative fact in justifying the settlement of pending patent litigation between competitors with competing patents is the good faith of the parties. *Standard Oil Co. of Indiana* v. *United States*, 283 U.S. 163, 180 (1931). Is there any evidence which can now help this court determine what facts were known by the Chavanoz/DMRC Group about the alleged invalidity and inapplicability of Chavanoz' patents when entering the 1964

agreements with the Leesona/Permatwist Group? Production is requested of whatever evidence there is about the alleged invalidity and inapplicability of Leesona patents in entering into the settlement agreements with the Leesona/Permatwist Group. It is the fact of the litigation between the Chavanoz/DMRC Group and Leesona, especially the 1964 settlement, which the Throwsters allege is itself a violation of the antitrust laws.

B. EVIDENCE LARGELY UNDER THE CONTROL OF CHAVANOZ.

All of the claimed patented inventions were invented in France either by employees of Chavanoz or employees of ARCT? In addition, all of the oppositions and patent infringement litigation was conductly directly or indirectly by Chavanoz. The execution and performance of all of the many agreements pertaining to Chavanoz patents were supervised directly or indirectly by Chavanoz. Studies and tests concerning ARCT machines were done at the direction of or with the approval of Chavanoz. Chavanoz was party to several European litigations involving foreign counterparts of many of the patents in suit. The negotiations for the patent settlement agreements of 1964 were directed by Chavanoz. The evidence as to knowledge, intent and good faith of the Chavanoz/DMRC Group lies largely in the files of Chavanoz or in the files of an affiliated company of Rhone-Poulenc, S.A. such as the Patent Department (DAPID) of Rhodiaceta.

C. UNDUE HARDSHIP.

There can be no doubt that the Throwsters have diligently pursued every avenue to discover the true facts. Their appeal to this court for these documents does not represent an avoidance of any responsibility to pursue evidence. The problem facing the Throwsters is a very practical one: The information contained in the documents is simply not available from any other source, irrespective of the degree of hardship they may experience. Attempts by the Throwsters to develop this information through depositions of persons likely to know it have, for several reasons, come to naught.

1. *Death of potential deponents.* The Throwsters had planned to take the deposition of the following key persons, each of whom died before his deposition was taken or was completed:

(a) Leo Soep, a patent consultant to Chavanoz ("conseil en brevets"), was one of the principal architects of the patent licensing system and the alleged illegal 1964 patent settlement agreements with Leesona. It is obvious from the record that Leo Soep as a patent consultant to Chavanoz generated, or was a recipient of, many of the documents being withheld.

(b) Dr. Norman Armitage was the principal architect of the patent licensing system for DMRC and the alleged illegal 1964 patent settlement agreements. He, too, died before he was deposed on Phase II matters.

(c) Mr. Walter Mueller, former Chief of the Patent Department of DMRC and conduit for processing Chavanoz' patent applications in the United States, also died before he was deposed on Phase II matters.

(d) Dr. Edward Murray, former head of technical research for DMRC, had a similar tragedy, as did:

(e) Dr. Dare Bolinger, a former technical employee of DMRC.

2. *Illness of potential deponents.* The Throwsters had planned to take the depositions of the following persons, each of whom was unable to be deposed because of illness:[3]

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[3] An attempt was made to take the testimony of each of these gentlemen in France. Arrangements, pursuant to Letters Rogatory obtained through the Justice Ministry of the Republic of France, were made to take this court to the hometown of each and to ap-

(a) Mr. Henri Servage, inventor of several of the important Chavanoz patents and a former Chavanoz plant manager.

(b) Mr. Louis Rouyer, inventor of several of the important Chavanoz patents.

(c) Mr. Warren Seem, inventor of several of the Leesona patents.

3. *Faulty memory on the part of important deponents.* During the three years of discovery, there has been a lack of recollection of crucial witnesses. Illustrative are Mr. Yves de Moncuit, Mr. Walter Mueller and Mr. Albert Davis.

(a) Mr. Yves de Moncuit, former technical director, manager and president of Chavanoz, who had supervised Chavanoz' false twist (FT) program from its very beginning.

(b) Mr. Walter Mueller, chief patent counsel for DMRC.

(c) Mr. Albert Davis, patent house counsel for Leesona.

STATEMENT OF LAW

This motion for reconsideration focuses on a single question of law and that question concerns the meaning of the second sentence in Rule 26(b)(3).[4] Some of the 47

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pear before a French judge who would supervise the depositions and would conduct them according to French procedures. After all arrangements were made and this court was in France, holding hearings in the American Embassy, on the eve of the trip to Southern France to take their testimony, both of the French inventors presented affidavits of illness, and the French Court, sua sponte, cancelled the depositions.

[4] Rule 26(b)(3), second sentence, provides:

> In ordering discovery of such [trial preparation] materials when the required showing [of substantial need and undue hardship] has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation.

documents contain mental impressions, an attorney's opinion or legal theories. Others do not.

A. *Burden of Proof.*

At times it was difficult for the court to tell whether the document was a brief or other legal memoranda because there really was no head to it and no tail to it—just a body. All of the documents, as pointed out in the prior in camera hearings, supposedly came from the patent owner's litigation files. The classical form of work product are the notes an attorney will write on a yellow pad of paper. At the head it may not have the name of the case and at the tail it may not have his signature but it will have written down the thoughts that reflect his mental processes. Thus, the very nature of work product documents is frequently such that the document is not stamped "WORK PRODUCT", does not contain a caption, does not have an addressee, and is not signed by its author. If anyone would look at such notes ten years after the fact, he or she would have a hard time deciphering them. Even though this describes the usual situation, the court places the burden of proving that a document is work product on the party claiming the privilege and resisting discovery. Such a burden appears to be just since the documents are usually in the exclusive control of the recalcitrant party and such party is the only one remotely capable of knowing, or likely to know or to discover, the exact nature of the document being sought. If the document cannot be shown to be work product, it should be produced because of an insufficient showing. If the document can be shown to be work product, the burden shifts to the party seeking discovery to show that it is in substantial need of the document for the preparation of its case and that denial of production will result in undue hardship. *Republic Gear Co.* v. *Borg-Warner Corp.*, 381 F.2d 551 (2d Cir. 1967); *Hauger* v. *Chicago, R.I. & P.R. Co.,* 216 F.2d 501 (7th Cir. 1954).

B. *Mental Impressions, Opinions, Conclusions, and Legal Theories.*

The literal language of Rule 26(b)(3) is extremely important. The first sentence discusses circumstances under which work product may be produced. The second sentence talks about a particular type of work product: "mental impressions, conclusions, opinions, or legal theories of an attorney, or any other representatives of a party concerning *the* litigation." (Emphasis added). This is an exception to a rule which otherwise allows production if this certain section has been met. The literal language of that sentence, in a vacuum and apart from the rest of the rule, prohibits disclosure of the type of material discussed in that second sentence.

What that sentence says, read in the context of the entire paragraph, is that if the party seeking production makes a showing of substantial need and undue hardship, it can get certain types of work product but it cannot get other types of work product. The words "protect against disclosure" cannot possibly be interpreted to mean "permit disclosure". Thus it appears that there is an absolute privilege against the disclosure of opinion work product documents in *pending* litigation.

One does not have to take this second sentence in a vacuum. One has to take it in the context of *Hickman* v. *Taylor* because, as the Fourth Circuit pointed out, it is well recognized that Rule 26(b)(3) is, in a large measure, a codification of *Hickman* v. *Taylor*. That is apparently what the drafters were attempting to do.

Looking at *Hickman* v. *Taylor*, it can be seen from the opinion that the Supreme Court is talking about two different types of work product. What the court was dealing with specifically in *Hickman* v. *Taylor*, 329 U.S., at 497, were "written statements of witnesses, or other information"—purely factual material. But the *Hickman* opinion went on to point out that there are other types of work product. In distinguishing work product from attorney-client documents, the court discusses other types of work product. It refers specifically to "the memoranda, briefs, communications and other writings prepared by counsel for his own use in prosecuting his client's case". *Id.*, at 508. The Supreme Court also refers to "an attorney's mental impressions, conclusions, opinions or legal theories". *Id.* This language is very important because it is copied verbatim in Rule 26(b)(3).

The holding in *Hickman* v. *Taylor* was that the work product privilege applied to both types of documents—to the purely factual materials and to the mental impressions, conclusions, opinions or legal theories. The Supreme Court in *Hickman* v. *Taylor*, and the Fourth Circuit in this case, were concerned with the morale of the legal advocacy profession. They were concerned that a lawyer and that those who work with a lawyer should be free to do their job without fear. In this context, there is nothing more central to the work that a professional advocate and his assistants do than framing and recording impressions, opinions, conclusions and legal theories.

Hickman v. *Taylor* then goes on to say that if a particular showing is made, certain types of work product may be produceable. Precisely, the Supreme Court says: "Where relevant and nonprivileged *facts* remain hidden in an attorney's file and where production of those facts is essential to the preparation of one's case, discovery may properly be had." *Id.*, at 511. Thus, while *Hickman* v. *Taylor* defines two types of work product—factual and opinion—and the privilege applies to both, a court may allow production *only* for factual material and *not* for opinion material in a presently pending lawsuit.

Hickman v. *Taylor* did not deal with prior terminated litigation. The Fourth Circuit did. It said that a qualified privilege continues for work product documents. It did not discern between factual and opinion material.

Since a qualified privilege exists for factual work product material in a pending case, it should follow that such a qualified privilege will continue once the litigation is ended. The question now before this court is whether the absolute privilege for opinion work product material in a pending case should also continue once the litigation is ended. This court has carefully and agonizingly weighed the consequences of its decision and has determined that the absolute privilege for opinion work product material in a pending case should be reduced to a qualified privilege once the litigation ends. The Throwsters have, as set forth in their statement of contentions appearing in Appendix A, charged Chavanoz as well as the other defendants and nonparty co-conspirators with a continuing combination and conspiracy in violation of Sections 1 and 2 of the Sherman Act to deny them a free and open market for the purchase of unlicensed royalty-free false twist machines as well as patent misuse and inequitable conduct in dealings with the United States Patent Office. In prosecuting their private actions against defendants, the Throwsters as "private attorneys general" have during the three years of discovery encountered obstacles in seeking to obtain production of documents and testimony.

The discovery period has shown that Chavanoz is in possession of key evidence on such subjects as prior false twist art, research and development on false twist machines and technology, patent applications and prosecutions in various countries of the world including dealings with patent offices, patent oppositions and patent infringement and validity litigation in various countries of the world, agreements relating to its false twist patents with many companies in Europe and the United States, use-royalties and use-licenses, invalidity/validity of its own and Leesona's patents, alleged efforts to prevent unlicensed royalty-free false twist machines from reaching the market, and arrangements with Leesona regarding their respective false twist patents throughout the world. These particular areas were central to prior litigation between Chavanoz and others relating to the patents in suit and other relevant false twist patents. Where, as here, the motivations for instituting such litigation and the reasons for and substance of subsequent settlements thereof are *key operative facts* in the Throwsters' antitrust contentions, the work product rule should *not* keep such conduct from scrutiny.

The work-product immunity asserted here as to the opinions and conclusions of both lawyers and non-lawyers alike in prior terminated litigation must be placed in perspective. Any privilege or immunity is an exception to the basic principle that justice demands that every litigant, corporate or otherwise, no matter how prominent or powerful, give this court any evidence required to permit justice to be done. 8 Wigmore on Evidence § 2192, at 70. In assessing any privilege or immunity the possible injury resulting from disclosure must be weighed against the benefit to be gained by correct disposal of litigation. *Garner* v. *Wolfinbarger*, 430 F.2d 1093 (5th Cir. 1970). Therefore, although the opinion work product immunity now applies equally to lawyers and non-lawyers, such immunity is not absolute. It is against this background that the legal standard of the Fourth Circuit's opinion is applied to this case.

What was a mental impression, opinion, conclusion, or legal theory, once absolutely protected during the pendency of a lawsuit, *may* change to an "operative fact" for a subsequent lawsuit, once the earlier lawsuit is terminated.

Here there are contentions that the 1964 settlement agreements between Leesona Corp. and the patent owner Chavanoz, (in the prior lawsuit and embroiled in this lawsuit) was actually an antitrust conspiracy. The mental impressions, opinions, conclusions, and legal theories of the attorneys in the prior litigation are now operative facts as to the motive and intent of the parties at the time of the settlement. The patent owner Chavanoz is in exclusive control of such operative facts. Production should be ordered.

There are also contentions that fraud was practiced on the U.S. Patent Office. The mental impressions, opinions, conclusions, and legal theories of the attorneys prosecuting the patent applications for Chavanoz are now operative facts as to the motive and intent of the patent owner in its dealings with the Patent Office. Again, since such operaive facts are in the exclusive control of the patent owner, production should be ordered.

The patent owner strongly urges that such an "operative fact" exception to the application of the second sentence of Rule 26(b)(3) to opinion work product documents in prior terminated litigation would destroy the second sentence of Rule 26(b)(3) and cut the heart out of the Fourth Circuit's opinion. It is pointed out that motive and intent are relevant in so many cases besides antitrust cases that an attorney will henceforth be afraid to express his opinion in writing during the course of a lawsuit for fear that it will later be discoverable in subsequent litigation. The court is aware of the importance that motive and intent play in the law. However, this court does not believe that the dire consequences predicted will result. This court is confident that when motive and intent of an attorney in earlier litigation become relevant in a later lawsuit that the judges in the United States District Courts, in exercising their sound discretion, will be capable of sifting out the wheat from the chaff—the good faith opinion work product from the bad faith opinion work product. An attorney, in conscientiously carrying out his duty as an officer of the court, should have no fear that his good faith efforts will not be recognized for what they are. Likewise, a lawyer, advising his client in an antitrust conspiracy or in a scheme to defraud the Patent Office, should not be allowed to enjoy the smug self-satisfaction that his legal talents are being used as a tool for the perpetration of a crime or a civil wrong and, because of the work-product rule, are forever protected against discovery. The denial of production of such documents from a prior terminated lawsuit would result in the suffocation of truth and the frustration of justice in the subsequent lawsuit.

This court finds persuasive authority for its analysis in several cases. In accordance with *Hickman* v. *Taylor* and Rule 26(b)(3) is the decision in *International Telephone & Telegraph Corp.* v. *United Telephone Co. of Fla.,* 60 F.R.D. 177 (M.D. Fla. 1973), where the court held:

> The mental impressions and legal theories of the attorney are, of course, entitled to greater protection than other so called 'work product materials'. Hickman v. Taylor, supra; Rule 26(b)(3) Federal Rules of Civil Procedure. Accordingly, the Court finds that at this time the plaintiff has not made a sufficient showing to invade the mental impressions of the attorneys . . . 60 F.R.D., at 187.

Although the Florida court found that plaintiff had not at the time made a sufficient showing to require discovery of "mental impressions, etc.", it clearly recognized that such a showing could be made and discovery ordered.

In *Bird* v. *Penn Central Co.,* 17 F.R. Serv.2d 1402 (E. D. Pa. 1973), the court ordered production of attorneys' memoranda containing mental impressions and legal conclusions relating to the sufficiency of a rescission claim upon the requisite showing. In so doing, the court said:

> Since the relevant inquiry is into what plaintiffs knew or should have known concerning grounds for their rescission action, only through discovery of information in the hands of plaintiffs, and their agents, can defendants substantiate their defense. Since in this case counsel served as investigators and advisors on the merits of the potential and actual claims asserted by defendants under the policy, and therefore alone could ascertain the justification for a rescission

> action, discovery of the relevant documents in their possession is essential to defendants' case.
>
> Because the nature of this defense concerns knowledge, legal theories and conclusions of plaintiffs' attorneys charged with claim investigation, such 'advice of counsel' evidenced in these documents is discoverable when it is directly relevant to a possible rescission action or suggests reasons to indicate the propriety of such an action. Rule 26(b)(3) on its face protects against the discovery of these aspects of the work product. However, exceptions have been made where such information is directly at issue and the need for its production is compelling as here. (Footnote omitted.) 17 F.R.Serv.2d, at 1405.

Similarly, in *Kearney & Trecker Corp.* v. *Giddings & Lewis, Inc.*, 296 F.Supp. 979 (E.D. Wis. 1969), the court stated:

> Thus the *Hickman* case established what has been termed a "qualified immunity"; See 2A Barron and Holtzoff, Federal Practice and Procedure § 652, and documents embodying the mental impressions of counsel, his legal conclusions, factual analysis and strategy, are normally inviolate and discoverable only upon an exceptional showing of justification. *Insurance Co. of North America* v. *Union Carbide Co.*, 35 F.R.D. 250 (D. C. Colo. 1964).
>
> *The determination of whether there has been a sufficient showing of 'exceptional circumstances' under Hickman* v. *Taylor is largely a matter of discretion* . . . . 296 F. Supp., at 982 (Emphasis added.)

In holding that circumstances sufficient to negate the claim of immunity under the work product rule had been shown, the court in *Kearney & Trecker* stated:

> The work product rule is essentially a balance between the need for discovery and one's right to retain the benefit of his own research. The policy behind the immunity is to protect from disclosure the 'fruits of a lawyer's labors'. *United States* v. *Swift & Co.*, 24 F.R.D. 280, 284 (N.D. Ill. 1959). In the case at bar,

> the defendants challenge the motives of and procedures used by the plaintiff in obtaining the patents in suit. This challenge involves, to a large extent, the activities of the plaintiff's attorneys, both inside and outside the corporate structure. Thus, it is the very 'fruit' of the lawyers' labor that is being called into question by the defendant in this case. (See *Insurance Company of North America v. Union Carbide Company*, 35 F.R.D. 520, 524 (D.C. Colo. 1964). 296 F.Supp., at 982.

It is interesting to note that as a direct result of the documents ordered produced, the patent owner was later found guilty of practicing a fraud on the Patent Office. *Kearney & Trecker Corp.* v. *Giddings & Lewis, Inc.*, 452 F.2d 579 (7th Cir. 1971), *cert. denied*, 405 U.S. 1066, 31 L.Ed.2d 796 (1972).

Subsequent to *Hickman*, the following cases ordered discovery of "mental impressions, etc." despite a claim of work product immunity: *United States* v. *Brown*, 478 F.2d 1038 (7th Cir. 1973) (attorney's memorandum summarizing notes and legal judgments ordered produced[5]); *Merrin Jewelry Co.* v. *St. Paul Fire and Marine Insurance Co.*, 49 F.R.D. 54 (S.D. N.Y. 1970) (reports, recommendations and decisions ordered produced); *Bourget* v. *Government Employees Insurance Company*, 48 F.R.D. 29 (D. Conn. 1969) (letters, reports, etc., including those of an attorney, ordered produced); *O'Boyle* v. *Life Insurance Co. of North America*, 299 F.Supp. 704 (W.D. Mo. 1969).

O'Boyle was an action in which plaintiff sought recovery of penalties and attorneys' fees for vexatious refusal to pay an insurance claim. The court ordered production of a memorandum prepared by the defendant's claims service manager in which denial of the claim was directed and the reasons for the denial were discussed. In ordering production, the court stated:

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[5] In *Brown*, the court held:

> "The strong public interest as expressed by Congress in enforcement of the Internal Revenue Act, may, however, be relevant in considering the degree of necessity which need be shown prior to the enforcement of an order to produce." 478 F.2d, at 1041.

> The issue is more sensitive in respect to item (4) which contains *thought process of tactics and strategy* of a claims officer in denying the claim. Nevertheless, there is no privilege (See 8 Wigmore, Evidence paragraph § 2285 (3d. Ed. 140). The matter is relevant, and perhaps admissible on the vexatious refusal issue. It is further calculated to lead to the discovery of admissible evidence. In this case good cause exists because it is discoverable at least on the issue of vexatious delay, *it describes the thought processes and basis of the decision to deny the claim and thus it would be unjust not to allow discovery.* Opinions of agents of parties are discoverable where denial of production of such would cause injustice to the discovering party's case. *Southern Railroad Co.* v. *Lanham*, (C.A. 5) 403 F.2d 119. These are material to reasonableness and good faith of the refusal to pay. See Moore's Federal Practice paragraph 26.23 [3], p. 1336. (Emphasis added). 299 F.Supp. at 706.

In summary, the court finds that, consistent with the opinion of the Fourth Circuit Court of Appeals, the decision in *Hickman*, and Rule 26(b)(3), this court may in its discretion order the production of opinions and conclusions where the denial of such production would frustrate the demands of justice and result in suffocation of the truth.

CONCLUSIONS OF LAW

After a review[6] of all the prior case law under the old standard of "good cause" and of the sparse case law under the new standard, this court has concluded that a sufficient showing of substantial need and undue hardship is made out in all of the following situations:

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[6] Wright & Miller, 8 Federal Practice & Procedure, § 2025 (1970).

1. *Operative facts known only to witnesses no longer available because of death or illness.* If a witness is not available to supply factual information sought, the court will order production of his documents. *McDonald* v. *Prowdley*, 38 F.R.D. 1 (W.D. Mich. 1965) (production of statement required of witness who was in the armed forces and unavailable); *Hanson* v. *Gartland S. S. Co.*, 34 F.R.D. 493 (N.D. Ohio 1964) (statements of seamen who cannot be found at address given by defendant are subject to discovery); *Goldner* v. *Chicago & N.W.R. Systems*, 13 F.R.D. 326 (N.D. Ill. 1952) (production of statements ordered when moving party could not locate the witness after diligent effort); *Fowler* v. *Wirtz*, 34 F.R.D. 20 (S.D. Fla. 1963) (shows that defendant's delay in furnishing names and addresses of persons believed to have knowledge or relevant facts had made it difficult or impossible for plaintiff to take their depositions); see generally 4 Moore, *Federal Practice*, 26-427, n. 12, and cases cited therein. The reasoning in these cases applies *a fortiori* when the party from whom the factual information sought is dead.

2. *Operative facts known only to witnesses with faulty memories.* The court will order the production of documents if the witness has a faulty memory as to the factual material in question. *United States* v. *Murphy Cook & Co.*, 52 F.R.D. 363 (E.D. Pa. 1971) (production of statement should be ordered if witness has faulty memory and can no longer relate details of event); *McDonald* v. *Prowdley*, 38 F.R.D. 1 (W.D. Mich. 1965) (statement taken from witness involved in accident would be ordered produced because he later could not remember significant details of accident); *Hanover Shoe, Inc.* v. *United Shoe Machinery Corp.*, 207 F.Supp. 407 (M.D. Pa. 1962) (when plaintiff's president did not recall details of meeting he had years before with defendant's president and attorney, sufficient showing was

made to require production of memorandum of the meeting); *Hall Bartlett Products* v. *Republic Pictures*, 20 F.R.D. 625 (S.D. N.Y. 1957) (where corporate officer disclaimed knowledge without reference to records, good cause is shown for production of such records to refresh memory); see generally 4 Moore, supra, at 26-433, n. 15, and cases cited therein.

3. *Operative facts gathered by lawyers and non-lawyers where they are relevant, may lead to admissible evidence, and are in the exclusive control of the party resisting discovery.* The court will order production of documents containing factual material that is relevant, although not itself admissible, but may lead to other admissible evidence, and is in the exclusive control of the party resisting discovery. *In re Natta*, 264 F.Supp. 734 (D. Del. 1967) (discovery allowed in patent case upon showing that documents were relevant and that information contained in them is, by its nature, within exclusive knowledge of opponent); *Zenith Radio Corp.* v. *Radio Corp. of America*, 121 F.Supp. 792 (D. Del. 1954) (plaintiff in patent litigation met requirements for production of documents when it demonstrated both relevance of documents to patents in suit, and that the information was in the sole control of defendant).

A. *Relevant operative facts—patent owner's knowledge of prior art and its position on the meaning of its patent claims as expressed in technical expert opinions involving the patents now in suit.* *United States* v. *Meyer*, 398 F.2d 66 (9th Cir. 1968) (in condemnation cases, full pretrial disclosure of appraisers' opinions and details on which they are based is required); *Lucy* v. *Sterling Drug, Inc.*, 240 F.Supp. 632 (W.D. Mich. 1965) (court may permit one party to examine an expert engaged by adverse party, or to inspect records prepared by such experts, if it is shown that facts or information sought are necessary for moving party's preparation for trial and could not be obtained by moving party's independent investigation or research); *Willett v. General Electric Co.*, 306 A.2d 789 (N.H. 1973) (defendant's contention rejected that reports of engineering firm hired to investigate fatal explosion were not producible as work product of its attorney because expert opinion was relevant as operative fact on condition of premises); Friedenthal, Discovery and Use of an Adverse Party's Expert Information, 14 Stanford L. Rev. 455 (1962); Long, Discovery and Experts Under the Federal Rules of Civil Procedure, 39 Wash. L. Rev. 665 (1964); Note, Discovery of Expert Information, 47 No. Car. L. Rev. 401 (1969). Expert opinions relate to technical information and therefore are factual work product which enjoys only a qualified privilege both in present pending litigation as well as prior terminated lawsuits.

B. *Relevant operative facts—patent owner's knowledge of the prior art and its position on the meaning of its patent claims—as expressed in briefs filed with courts in prior terminated litigation.*

Since Chavanoz was engaged in numerous patent infringement suits in Europe involving patents corresponding to those contested in the pending patent-antitrust litigation, the Throwsters requested production of the briefs and other similar materials as sources of factual information on the patent owner's knowledge and/or bad faith to support their antitrust and patent misuse contentions and not for the mental impressions as such.

The Throwsters are clearly entitled to know what positions were taken by Chavanoz with respect to its own or other false twist patents in other litigation. Statements made in briefs and similar materials prepared for these prior cases might constitute admissions in the litigation at bar. Indeed, Chavanoz might be estopped from taking a position in this litigation that is inconsistent with a position taken by it in prior litigation. See Moore, 1B *Federal Practice*, § 0.405[8] "Preclusion Against Inconsistent Positions".

Briefs and similar materials are, under the French Court system, not retained on file upon termination of a case. The drafts submitted to this court in camera review indicate that final versions were filed in some form. Therefore, unless Chavanoz comes forward with the briefs and similar materials as actually filed, the drafts constitute the "best evidence" of the positions taken by Chavanoz in prior litigation and have been ordered to be produced.

The assertion by Chavanoz that the burden should be on the Throwsters to establish whether a particular draft was ever finalized and filed is absurd. Chavanoz, and not the Throwsters, is the party resisting production and has, therefore, the burden of showing to the court's satisfaction that it has complied with all the elements. As counsel for Chavanoz recognized during his argument on January 4, 1974, it is impossible for the Throwsters to determine whether Chavanoz had ever finalized and filed a draft which they have never seen. On the other hand, the materials were prepared on behalf of Chavanoz and it is the party chargeable with knowledge of whether they were ever finalized and filed. Unless Chavanoz can come forward with affirmative evidence that the drafts were never finalized and filed, it must be concluded that they were and that, absent production of those finalized versions, the drafts should be produced.

4. *Operative facts—patent owner's motive and intent in the 1964 settlement agreement with Leesona and in the prosecution of various patents before the U. S. Patent Office—as expressed in attorneys' mental impressions, opinions, conclusions, and legal theories in prior terminated litigation.* The court will order production of documents containing an attorney's opinion in a terminated lawsuit only where such opinion work product appears to show bad faith motive and intent. See *Bird* v. *Penn Central Co.*, supra; *United States* v. *Brown*, supra; *International Telephone & Telegraph Corp.* v. *United Telephone Co. of Fla.*,

supra; *Kearney & Trecker Corp.* v. *Giddings & Lewis, Inc.*, supra; *O'Boyle* v. *Life Insurance Co. of North America*, supra.

This order, not otherwise appealable because if its interlocutory nature in the opinion of this court involves a controlling question of law as to which there is substantial ground for difference of opinion, and an immediate appeal from the order may materially advance the ultimate termination of the litigation. This statement is made in accordance with Title 28, United States Code, Section 1292.

The effective date of this order shall be February 15, 1974.

AND IT IS SO ORDERED.

/s/ ROBERT W. HEMPHILL
Robert W. Hemphill
United States District Judge

Rock Hill, South Carolina

February 5, 1974.

APPENDIX A

The Throwsters' specific antitrust and patent misuse claims may be categorized as follows:

1. Restrictions on use of ARCT false twist machines after purchase and passage of title—violations of Section 1 of the Sherman Act and of Section 7 of the Clayton Act.*
2. Restriction on resale of ARCT false twist machines —violations of Section 1 of the Sherman Act.
3. Agreements affecting the availability to competitors of equipment and supplies essential to their business, and affording a conspirator anticompetitive access to confidential information—violations of Section 1 of the Sherman Act.
4. Package licensing—violations of Section 1 of the Sherman Act and patent misuse.
5. Attempts to monopolize by defendants through practices of DMRC-violations of Section 2 of the Sherman Act.
6. 1964 Agreemnts among Chavanoz, DMRC, ARCT-France, Whitin, and Leesona—violations of Section 1 and Section 2 of the Sherman Act.
7. Attempts and agreements to extend the monopoly under the Chavanoz patents beyond the lawful time, scope and subject matter of the patent monopoly—violations of Sections 1 and 2 of the Sherman Act and patent misuse.
8. Inequitable conduct in dealings with the United States Patent Office—unenforceability of the patents and violations of Sections 1 and 2 of the Sherman Act.
9. Acts independently establishing patent misuse— unenforceability of the patents and license agreements.
10. Collusive restraints on magnetic spindles— violations of Section 1 of the Sherman Act.

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* References throughout this Statement to the Sherman Act also include a section of the Wilson Tariff Act, 15 U.S.C. § 8, which specifically proscribes restraints of trade involving articles imported into the United States.

APPENDIX B

Categories assigned by Throwsters to documents alleged not to be privileged:

I. The claimed attorney-client privilege was waived by the client.

II. Miscellaneous.

III. The claimed work product document was filed or published with a court.

IV. The claimed attorney-client privilege fails because of a disclosure to a third party.

V. The claimed attorney-client privilege and/or work product rule fails because the attorney was acting as a conduit.

VI. The claimed attorney-client privilege fails for want of confidentiality.

VII. The claimed attorney-client privilege and/or work product rule fails because of abuse of the privilege or the rule.

VIII. The claimed work product document post-dates the termination of the prior litigation.

IX. The claimed work product was prepared for an opposition or other patent office proceeding which was not handled by a member of the bar.

X. The claimed work product document antedates the termination of the prior litigation.

XI. The claimed attorney-client privilege and/or work product rule fails because of an insufficient showing.

XII. Documents which the Throwsters are not contesting on the basis of the information contained in the transcripts.

APPENDIX C

COMMENTS AND COURT RULINGS ON CLAIMED WORK PRODUCT DOCUMENTS RELATING TO PRIOR TERMINATED LITIGATION.

Cat. 2, Doc. 211 (French): Six-page document without any given author, without any given addressee, without any date. A discussion of twist and false twist in the case of Chavanoz v. Universal Winding, now known as Leesona Corporation. This appears to be an expert's report. It contains relevant operative facts as to the patent owner's knowledge of the prior art. These operative facts were apparently gathered by a non-lawyer. They are relevant, may lead to admissible evidence and are under the exclusive control of the party resisting discovery. Although this document is work product the privilege will not be honored.

Cat. 3, Doc. 211 (French): This is a reply to the memorandum of Universal Winding, now Leesona Corporation, whose memorandum was originally dated 25 July 1959 in reply to a Chavanoz memorandum of 12 March 1959. This document is three pages long. It is directed to the experts of the French court. On the last page there is a hand-drawn line indicating the transposition of one phrase. On the last line of the last page, it says "Paris, 1959" with a blank space for the exact date. This may or may not be a draft. There is no indication whether or not this document was filed with any French tribunal. However, because of the good condition of these three pages this court assumes that a document of similar nature, if not this document itself, was in fact, filed with some tribunal. This court is also assuming that the document filed with the tribunal is in all the essential respects the same as this "draft" that was taken from the Chavanoz litigation files. This document contains relevant operative facts bearing on the patent owner's position on the meaning of the patent claims. Even though this document is work product the privilege will not be honored. A copy of the original filed with the court will be produced but in lieu thereof, this document will be produced.

Cat. 3, Doc. 212 (French): A 14-page brief for Chavanoz in the case of Chavanoz v. Universal Winding, now Leesona Corporation, and Lainiere de Roubaix. It is unsigned but the first page bears the stamp Alain le Tarnec, an Avocat in Paris. It is unsigned but it begins with the heading "May It Please The Court". On page 12 there are two handwritten additions of two French words. It is addressed to the President and the counsellors of the chamber of the Court of Appeals at Douai. On its face there is a strong indication that this document was filed with a French tribunal. In the absence of any evidence to the contrary by the patent owner, the document will be produced. Even though this document is work product, its filing with the court makes it a public record for which a work product privilege cannot attach.

Cat. 3, Doc. 225 (French): This is a two-page document entitled "Reply to the Memorandum of Universal Winding For the Experts". In the upper lefthand corner of the first page there is a note that this was written by Leo Soep. There are three handwritten changes on page 2 of this document. This document is apparently a draft of the three-page document known as No. 211. Since No. 211 was ordered produced, this document need not be produced since it is a draft thereof.

Cat. 3, No. 415 (French): A 17-page memorandum in the case of Leesona v. ARCT, dated 28 September 1961. There is an illegible signature at the end but in the upper lefthand corner of the first page there is a notation that this document was prepared by the conseil en brevets, Leo Soep, now deceased. It contains a discussion of the validity and infringement of three French patents. It does not appear to have been filed with any court. There are a number of handwritten notations in the margins. This document is clearly work product but because it contains operative facts of the patent owner's knowledge of the prior art, known only to a witness, no longer available because of death, the work product privilege will not be honored. The document will be produced.

Cat. 3, No. 416 (French): This is a 4-page document with the heading, Leesona Corporation v. ARCT, dated December 12, 1961. It is signed Leo Soep, now dead. It discusses the validity of two French patents. This document does not appear to have been filed with any court. It is clearly work product, but it contains operative facts as to the patent owner's knowledge of the prior art, known only to a witness no longer available because of death. Therefore, the work product privilege will not be honored. Furthermore, page 3 of this 4-page document is missing. The patent owner will produce it.

Cat. 3, No. 417 (French): A 4-page document prepared by Leo Soep, dated February 17, 1961, in the case of Leesona Corporation v. ARCT. I tis entitled. "Addition to the Provisional Response of January 10, 1961, to the First Note of January 7, 1961". It does not appear to have been filed with any court. It contains a discussion of a meeting held on January 13, 1961, in the office of M. Rousselet, President of the College of Experts with the French court. It discusses remarks of the court experts on a French patent. This document is clearly work product, but since it contains operative facts on the patent owner's knowledge of the prior art, known only to a witness no longer available because of death, the privilege will not be honored. The document will be produced.

Cat. 3, No. 418 (French): A 3-page document prepared by Leo Soep, dated January 10, 1961, relating to Leesona Corporation v. ARCT It is entitled, "Provisional Response to the First Note dated January 7, 1961". This is the document apparently referred to in the document known as No. 417. This document also discusses a French patent. It was not filed with the court apparently. It is clearly work product but since it contains operative facts as to the patent owner's knowledge of the prior art, known only to a witness no longer available because of death, the privilege will not be honored. The document will be produced.

Cat. 3, No. 533 (French): A 2-page document prepared by Leo Soep in Paris, dated June 20, 1957. Its heading is, "Technical Note". It was prepared in connection with Chavanoz' suit against Bonneterie Cevenole and Ernest Scragg and Co. The document discusses a French patent owned by Chavanoz which the two parties are accused of infringing. This document is clearly work product. This document contains operative facts gathered by a non-lawyer that are relevant and may lead to admissible evidence and are in exclusive control of the party resisting discovery. The relevant operative fact is the patent owner's prior position as expressed in this technical note involving a U.S. version of this French patent now involved in this suit. Since this operative fact is known only to a witness no longer available because of death, the work product privilege will not be honored, and the document will be produced.

Cat. 3, No. 534 (French): Two copies of a one-page note entitled "Addition to the Technical Note for the Tournon Court Case Against Ernest Scragg & Sons, Ltd." It is unsigned and not addressed to anyone but is apparently in connection with litigation. This is clearly work product and therefore will not be produced.

Cat. 3, No. 535 (French): A 14-page document prepared by Leo Soep in Paris, dated March 23, 1959. It is entitled, "Technical Note, Chavanoz v. Bonneterie Cevenole, Cevennes and Ernest Scragg, Ltd." It contains the history of the French patent owned by Chavanoz in suit and two patents of addition. There is also a discussion of documents and foreign patents cited in opposition to the main French patent and its two additions. This document was not prepared for a court and is clearly work product but contains operative facts as to the patent owner's knowledge of the prior art known only to a witness no longer available because of death. Therefore, the document will be produced.

Cat. 7, No. 443 (English): A letter dated February 4, 1964 from Granville Brumbaugh to Ward Smith, Esquire, in Whittensville, Massachusetts, discussing the Whitin v. Leesona case. The letter sets forth Attoreny Brumbaugh's mental impression and opinions concerning proceedings in the litigation. This document is clearly work product and does not contain any operative fact as to the patent owner's motive and intent in the 1964 settlement agreement with Leesona. The document is effectively inconsequential and production will not be of any consequence. Therefore, the privilege will be honored. The document will not be produced.

Cat. 9, No. 579 (English): A letter from J. A. Kemp to Leo Soep dated March 6, 1963 in reference to the Chavanoz-Heberlein agreement and the Chavanoz v. DeBonair, Ltd., and Ernest Scragg & Sons, Ltd. lawsuit. This letter contains the mental impressions of the British patent agent and is clearly work product. Since no relevant operative facts are involved, the privilege will be honored.

Cat. 9, No. 580 (English): A one-page letter from Leo Soep to J. A. Kemp and Company, British patent agents in London, dated January 12, 1962, regarding an opposition to British patent application No. 881,729. This letter states Mr. Soep's opinion concerning litigation strategy and is clearly work product. Since no relevant operative facts are discussed, the privilege will be honored. The document will not be produced.

Cat. 11, No. 77 (French): A letter dated October 6, 1969, to the attention of Mr. Laurent. It is signed by "A Director" but the signature is illegible. The letter is written on ARCT stationery. There is a handwritten addition at the top of the page that says "Klinger-France-Expertise". The letter discusses a graph which is attached thereto dealing with twist. If this document deals with any patent involved in the Klinger litigation, it is not so stated. Since the expert's report does not contain any relevant operative facts dealing with any of the patents now in suit, the work product privilege will be honored. The document will not be produced.

Cat. 11, No. 94 (French): This is a one-page memorandum from Leo Soep, dated April 11, 1964. Copies are addressed to Chavanoz, DAPID and ARCT. It concerns his observations on the Klinger experiment. This document is clearly work product, but since it contains relevant operative facts on the patent owner's position on the meaning of its patent claims, known only to a witness no longer available because of death, the privilege will not be honored.

Cat. 11, No. 325 (English): A 3-page document prepared by Mr. Leo Soep with copies sent to J. A. Kemp and Company, the British patent agents, Chavanoz, DAPID and ARCT. It is dated July 2, 1969 in Paris and has the heading Chavanoz and ARCT v. Klinger. It discusses British Patent No. 745,337. This document contains an analysis of prior art patents raised by Klinger in the infringement action brought by Chavanoz. This document is clearly work product, but since it contains relevant operative facts on the patent owner's knowledge of the prior art known only to a witness no longer available because of death, the document will be produced.

Cat. 11, No. 551 (French): This is a 32-page unsigned document. Assistant Counsel for the patent owner admits that he penciled in in English the word "draft" in the upper righthand corner of the first page. The first paragraph on the first page indicates that this document was involved in the case of Chavanoz v. Lainiere de Roubaix and Universal Winding Company, now Leesona Corporation. The document is unsigned and undated but indicates that it relates to the infringement action against the two defendants on the patent owner's French patent No. 1,054,338 and the two patents of addition. The second paragraph on page one indicates that the document is directed to the President of the Civil Tribunal of Lille, France. In the middle of the first page is the heading that says, "Oral argument in favor of infringement". The document is unmarked throughout. The document starts with the history of the invention on page 3, the history of the patents of addition obtained by the patent owner starting at page 9, the opposing arguments of the defendants starting on page 16, and the statement as to how there is an infringement in law by Universal Winding Company starting at page 28. The last page is entitled, "Prayer For Relief". On the basis of the foregoing description, the court is compelled to assume that this document was in fact filed with the French tribunal or at least that a document in all essential respects was so filed. Therefore, although this document is clearly work product, the fact that it was published with a court of law removes any privilege that may attach. A copy of the document for which this document is purportedly a draft shall be produced and in the event that such document is not produced, then this document shall be produced in lieu thereof.

Cat. 11, No. 552 (French): This is an 11-page document addressed to the President and Judges composing the tribunal at Lille. It is unsigned and undated. The heading at the top of the first page in capital letters says, "Conclusions of the Experts For Chavanoz Plaintiff against Universal Winding Company and Lainiere de Roubaix Defendants, May It Please The Tribunal". There are two handwritten additions. It first appears in the title behind the term Universal Winding and makes a reference to Leesona Corporation. The second appears on page 10. The body of the document starting at page 2 makes a reference to French Chavanoz patent No. 1,054,338 and two patents of addition. On its face this document appears to be a brief filed with a French court or at least a draft of such a brief. This court is compelled to assume that a document of similiar nature was in fact filed or at least a document in all essential respects. Since the work product privilege cannot attach to any document made public through a filing with a court, a copy of the document submitted to the court at Lille shall be produced. In the event that such a document is not produced, then this document shall be produced in lieu thereof.

Cat. 11, No. 553 (French): This is a 7-page document entitled, "Conclusions for Chavanoz, the Plaintiff, against Universal Winding Company and Lainiere de Roubaix, Defendants, May It Please The Tribunal". Unlike some of the earlier documents examined, this one appears to be clearly a draft of a brief since there are about one-half dozen additions in the margins and delineations in the text. This document is unsigned and undated. It discusses infringement by the two defendants of Chavanoz French Patent No. 1,054,338, and its two patents of addition. Since this document was apparently not filed with the court, Chavanoz will produce the original filed with the court, or in lieu thereof, this document will be produced because it contains relevant operative facts as to the patent owner's position on the meaning of its patent claims in prior terminated litigation.

Cat. 10, No. 25 (French): This is a one-page letter from Leo Soep to Mr. deMoncuit, dated January 7, 1964. The letter refers to the Klinger problem and was obviously prepared in anticipation of litigation. This document is therefore work product of a French patent agent. Although the author, Mr. Soep, is dead, and the addressee, Mr. deMoncuit has a faulty memory as to this matter, the document will not be produced since it contains no relevant operative facts in this litigation.

Cat. 10, No. 85 (French): This is the only document that this court takes up sua sponte. It is an expert's report prepared for Chavanoz in the Klinger litigation. It has the signature of Mr. Marconnet, a French avocat, at the bottom. The document discusses French patents owned by Chavanoz involved in the litigation. Since this document contains relevant operative facts as to the patent owner's knowledge of the prior art as expressed in this technical expert's report involving counterparts of the patents now in suit, this document will be produced. Although such a document is ordinarily work product, the privilege will not be honored. The document will be produced.

Cat. 10, No. 87 (French): An English translation of this document has been provided by the patent owner. This is a one-page letter from Mr. Leo Soep to the Patent Department, DAPID, of Rhodiaceta, Chavanoz' parent company. It is dated April 8, 1969 in Paris with a notation that it should be referred to MIL, apparently Mr. Michael Laurent, a French patent agent working for DAPID. There is another notation that it relates to the experts in the Klinger-France litigation. This document states Mr. Soep's conclusions concerning a draft of the brief to be filed with a court. Even though Mr. Soep, the author, is dead, this document will not be produced as it contains no relevant operative facts for this present litigation. The privilege of this document as work product therefore is honored. The document will not be produced.

Cat. 10, No. 100 (French): This is a 2-page letter on ARCT stationery, signed by Mr. Henri Crouzet to Mr. Laurent, a patent agent in the Patent Department of Rhodiaceta. It is dated February 3, 1969, and deals with the infringement litigation against Klinger. Mr. Crouzet signed the letter as President of ARCT. He is neither a patent attorney nor a patent agent, however, he is an expert on false twist machines. This letter appears to contain his expert opinion on the accused infringing Klinger machines. Since the work product privilege under Federal Rules of Civil Procedure 26(b)(3) is not limited to attorneys, but applies equally to the work product of lawyers and non-lawyers, such as Mr. Crouzet, that privilege will be honored here since no relevant operative facts in this litigation are contained in this letter. The document will not be produced.

Cat. 10, No. 209 (French): This 7-page document, dated June 30, 1961, is entitled, "Technical Critique of the Judgment of the Trial Court of Lille of May 26, 1961" in the case of Chavanoz v. Leesona. From the typewritten initials *"LS"* in the upper lefthand corner of the first page it appears that this document was prepared by Leo Soep, now deceased. This document contains about one-half dozen handwritten changes throughout. This document is apparently an internal memorandum stating Mr. Soep's opinions, conclusions and legal theories concerning the trial court's decision that was subsequently and successfully appealed by Chavanoz, according to the statement by the patent owner's counsel in this case. The action that was the subject of this memorandum was still pending at the date stated, June 30, 1961, but did not terminate until 1964. Although the patent owner's motive and intent in the 1964 settlement agreement with Leesona, is the subject of this lawsuit as an antitrust violation, this document contains no operative facts relevant thereto. Therefore, the privilege of this document as work product will be honored, even though the author is no longer available because of his death. The document will not be produced.

Cat. 10, No. 217 (French): A 3-page document authored by Leo Soep and dated March 9, 1964 entitled, "Chavanoz v. Leesona Corporation". There are numerous handwritten changes made throughout the document. There is a discussion of prior litigation in the French courts between these two parties and reference is also made to Chavanoz French Patent No. 1,054,338 and the two patents of addition. This document is apparently a draft of an internal memorandum stating Mr. Soep's opinions, conclusions and legal theories. This document will be produced since it contains relevant operative facts as to the patent owner's motive and intent in the 1964 settlement agreement with Leesona.

Cat. 10, No. 329 (French): A one-page letter dated June 6, 1968 from Mr. Leo Soep to Mr. Yves deMoncuit. There is a handwritten notation that this letter is in relation to the Klinger-France litigation brought by Chavanoz. Although there is no reference throughout the body of the letter to Klinger, this document contains Mr. Soep's legal opinion as to the expert's testimony in a case before a French tribunal, apparently involving Chavanoz. Even though Mr. Soep is dead and Mr. deMoncuit has repeatedly displayed a faulty memory, this document contains no relevant operative facts as to this litigation. The privilege of this document as work product is therefore honored. The document will not be produced.

Cat. 10, No. 351 (French): A one-page letter from Leo Soep to the Patent Department, DAPID, of Rhodiaceta, the parent company of Chavanoz. There is a notation that this letter is to be referred to someone with the initials "MIL" apparently Mr. Michael Laurent. The letter is dated July 4, 1968 in Paris, France, and concerns the infringement action against Klinger in Great Britain. This document contains penciled impressions on trial strategy suggested by Mr. Soep. Even though Mr. Soep is dead, this document contains no relevant facts to the present litigation and therefore, as work product, this document will not be produced.

Cat. 10, No. 359 (French): A two-page letter from Mr. Leo Soep to the Patent Department, DAPID, of Rhodiaceta. This letter appears to have been meant to be referred to Mr. Michael Laurent according to a notation of the initials "MIL" in the lefthand corner of the first page. The document discusses the Chavanoz v. Klinger-Great Britain litigation. A copy of the letter was sent to Mr. deMoncuit. There are several handwritten notations in the margins of both pages. The letter is dated April 24, 1968 in Paris, France. This letter apparently concerns mental impressions of Mr. Soep concerning trial strategy. Even though Mr. Soep is no longer available to testify because of his death, this document will not be produced because it contains no relevant operative facts as to this litigation.

The privilege of this document as work product is therefore honored. The document will not be produced.

Cat. 10, No. 365 (English): This is an unsigned one-page letter from the patent owner corporation Chavanoz, dated February 6, 1968, addressed to J. A. Kemp and Company, patent agents in London, England, concerning an infringement action intended to be brought against Klinger Manufacturing Company in Great Britain on Chavanoz' British Patent No. 745,337. This document obviously contains the mental impressions of someone concerning the anticipated litigation. Even though it cannot be ascertained whether the author is a lawyer or non-lawyer, it does not matter since the work product privilege applies to both. Since this document contains no operative facts relevant to the present litigation, the work product privilege will be honored. The document will not be produced.

Cat. 10, No. 367 (French): This is a one-page letter dated January 15, 1968 from Mr. Leo Soep to apparently Mr. Michael Laurent at DAPID, the Patent Department of Rhodiaceta. Copies were sent to Chavanoz and ARCT. The document states Mr. Soep's mental impressions and conclusions with respect to preparation for the anticipated litigation against Klinger Manufacturing Company in Great Britain. Regardless of the fact that Mr. Soep is deceased, this document contains no operative facts as to the present litigation. The document clearly being work product will therefore not be produced.

Cat. 10, No. [illegible]7 (English): A one-page unsigned letter to Mr. Cannon, a British patent agent with J. A. Kemp and Company in London. The letter is dated March 22, 1971, and relates to the Chavanoz v. Klinger litigation. The letter discusses the problem of registering an ARCT-Chavanoz license. Even though there is a heading that this letter refers to the Klinger litigation, this court cannot ascertain any mental impression, conclusion, opinion or legal theory for which work product privilege might attach. There is, therefore, an insufficient showing that this document is work product and thus no privilege attaches. The letter will be produced, the patent owner not having carried its burden of proof.

Cat. 10, No. 403 (French): A one-page letter from Mr. Leo Soep on Chavanoz' stationery to Mr. deMoncuit. The letter is dated January 17, 1964 in Paris and refers to the infringement action of Chavanoz against Leesona in the court at Douai. This document contains operative facts relevant to the patent owner's motive and intent in the 1964 settlement agreement with Leesona and should be produced, especially in view of the fact that Mr. Soep is dead and Mr. deMoncuit has consistently displayed a faulty memory in regards to this matter. The privilege of this document as work product will therefore not be honored. The document will be produced.

Cat. 10, No. 404 (French): This is apparently a report written by Mr. Leo Soep on April 1, 1963 concerning a trip to Douai taken on March 29, 1963 regarding the appeal of Chavanoz from the judgment of the tribunal of Lille in the case of Chavanoz against Leesona. In the upper righthand corner is the handwritten name of Mr. Morel. The document contains Mr. Soep's mental impressions of the court's attitude on Chavanoz' appeal and therefore it is clearly work product. Although Mr. Soep is dead, this document contains no operative facts relevant to this litigation and therefore will not be produced.

Cat. 10, No. 405 (French): A three-page memorandum, signed by Leo Soep in Paris, dated March 5, 1962 entitled, "Chavanoz v. Leesona Judgment of Tribunal at Lille of May 26, 1961". This document contains remarks and mental impressions of the French patent agent on the judgment of the trial court presently on appeal at the time of this document's writing. This internal memorandum is not directed to anyone in particular and the litigation discussed did not terminate until 1964. Even though the patent owner's motive and intent in the 1964 settlement agreement with Leesona is contested to be an antitrust conspiracy in the present litigation, this document contains no operative facts relevant thereto and therefore even though the author, Mr. Soep, is dead, the work product privilege of this document will be honored. The document will not be produced.

Cat. 10, No. 406 (French): A seven-page document prepared by Mr. Leo Soep, dated in Paris on June 30, 1961. It is entitled "Technical Critique of the Judgment of the Tribunal at Little of May 26, 1961 in the case of Chavanoz v. Leesona". This document is apparently an internal memorandum stating Mr. Soep's opinions, conclusions and legal theories concerning the trial court's decision which was subsequently and successfully appealed by Chavanoz. The action was still pending at the date of this memorandum and did not terminate until 1964. Even though the patent owner's motive and intent in the 1964 settlement agreement with Leesona is contended to be an antitrust conspiracy in this case, this document contains no operative facts relevant to that issue in this case and therefore even though Mr. Soep is dead, the work product privilege of this document will be honored, and will not be produced.

Cat. 10, No. 411 (French): This is three sheets of what the court would call "counter paper" on which various notes are made. This document has no author, no addressee, and no date. The notes are handwritten and discuss the case of Leesona v. ARCT. The document sets forth opinions, conclusions and legal theories concerning the patent infringement and validity issues in that suit. Even though there is no author, it is abundantly clear that this document was prepared by either a lawyer or a non-lawyer in connection with the litigation. These handwritten notes containing mental impressions appear to be the purest form of work product. Even though the patent owner's motive and intent in the 1964 settlement agreement with Leesona is asserted to be an antitrust violation in this lawsuit, this document contains no operative facts relevant to that issue. The work product privilege is therefore honored. The document will not be produced.

Cat. 10, No. 413 (French): This document is a report from Mr. Henri Crouzet to Mr. Leo Soep dated March 15, 1962 in Paris concerning the arguments of the experts in the case of Leesona v. ARCT. The report contains four pages of text, two pages of experimental results and eleven pages of graphs. This document contains relevant operative facts as to the patent owner's knowledge of prior art patents on machinery owned by Leesona and on the patent owner's interpretation of his own patent claims. Therefore, although this technical expert's opinion is work product the privilege will not be honored. The document will be produced.

Cat. 10, No. 414 (French): A two-page document written by Mr. Soep concerning a meeting held on February 23, 1962 at which Messrs. Crouzet, deMoncuit, Morel and Soep were present. The meeting concerned the litigation of Leesona against ARCT. Those at the meeting discussed critically the expert's opinion before the court in that case on the French Patent No. 1,128,409 owned by Chavanoz. This document is clearly work product since it contains the mental impressions, opinions and conclusions of both patent agents and other non-lawyers in that case. The work product privilege of this internal memorandum is honored since the document contains no operative facts relevant to the present litigation. The document will not be produced.

Cat. 10, No. 532 (French): A four-page document signed by Messrs. Petit, Martin, and Laurent dated April 1, 1968. It is the report on a hearing held in the case of Chavanoz v. Klinger-France on March 27, 1968. The document states who was present at the hearing, outlines the statements made by these parties in the suit and contains the personal impressions of the authors. This internal memorandum is clearly work product and contains no operative facts relevant to the present suit. The privilege will be honored.

Cat. 10, No. 554 (French): Three copies of a one-page document entitled, "Pleadings at Lille in the case of Chavanoz v. Leesona on March 15, 1961". It is signed by Mr. Leo Soep and apparently contains his mental impressions of the proceedings in that court. This is an internal memorandum that is clearly work product. However, it contains relevant operative facts as to the patent owner's knowledge of the prior art and as to its position on the meaning of its patent claims. Since these operative facts are known only to the witness Soep who is no longer available because of his death, the work product privilege will not be honored. The document will be produced.

Cat. 10, No. 574 (French): An extract from some notes of Mr. Leo Soep dated July 5, 1965. This one-page, three-paragraph paper is entitled, "Fluflon Limited". This document does not appear to have been prepared in anticipation of or in preparation for any particular litigation. It contains merely the present state of litigation against a number of accused infringers including Scragg and Debonair. As such the work product privilege cannot attach to this document because of the insufficient showing made by the patent owner in carrying the burden of proof. The document will be produced.

Cat. 10, No. 575 (English): This is a one-page, two-paragraph document dated November 11, 1964. From stenographic notes in the upper lefthand corner it appears that this document was prepared by Mr. Leo Soep. The document discusses the legal rights of Fluflon and Chavanoz as to any infringement action brought by either of the parties under an agreement between them. Thus, it appears that on its face this document is in anticipation of litigation—which litigation is not stated. Since this document does not relate to any operative facts relevant to the present proceeding, the work product privilege will be honored. The document will not be produced.

Cat. 10, No. 591 (French); An English translation of this document has been filed with the court by the patent owner. This is a one-page letter from the French patent agent Leo Soep to Mr. deMoncuit of Chavanoz, dated June 28, 1957, in Paris. The letter discusses the possibility of bringing an infringement action in the Granges-les-Valence affair. Counsel for the patent owner subsequently indicated that this document relates to Chavanoz' suit against Bonneterie Cevenole and Ernest Seragg and Son. The document states Mr. Soep's opinion concerning strategy in the anticipated litigation. As such the document is clearly work product. Even though Mr. Soep is dead and Mr. deMoncuit has a faulty memory as to this transaction, the letter itself contains no operative facts relevant to the present lawsuit and therefore the work product privilege will be honored. The document will not be produced.

Cat. 10, No. 594 (French): A two-page letter from Mr. Leo Soep dated June 21, 1957 at Paris, to Mr. deMoncuit of Chavanoz. This letter relates to Chavanoz' suit against Bonneterie Cevenole. There is also a postscript concerning a telephone conversation with Fred Seragg of Ernest Seragg and Sons. This document states Mr. Soep's opinion as a patent agent concerning strategy in an anticipated patent litigation. Even though the author, Mr. Soep, is dead and the recipient, Mr. deMoncuit, does not remember this transaction, the document will not be produced, since it contains no operative facts relevant to the present litigation.

Cat. 10, No. 599 (French): A 13-page document entitled, "Technical Note" in the case of Chavanoz v. Bonneterie Cevenole, Cevennes and Ernest Seragg, Ltd., dated March 16, 1959 in Paris and prepared by Mr. Leo Soep. Numerous and extensive handwritten additions and omissions in this document clearly indicates that it is a draft. It is apparently an earlier version of document 535 discussed beforehand. This document is clearly work product and because of the disposition of document 535, the privilege will be honored here. The document will not be produced.

Cat. 10, No. 622 (French): This is a 6-page unsigned and undated document. There are two pages numbered "3". The heading at the top of the first page says "Conclusions for Chavanoz, Plaintiff, represented by Mr. Beaume; against, Ernest Scragg & Sons, Ltd., Defendant, represented by Mr. Uzan; Bonneterie Cevenole, Defendant, represented by Mr. Gabbeau; and Cavennes, Defendant, represented by Mr. Gabbeau, also. May It Please The Court". Page 2 and the second page numbered "3" contains a number of handwritten changes and marginal notes. This indicates to this court that this document is a draft. Because of the heading of the document, this court assumes that a document of similar nature was in fact filed with a French court. The court also assumes that the document that was filed is in all essential respects the same as this draft before the court now. This document discusses the French patent No. 1,054,338 owned by Chavanoz and its two patents of addition. Also, a number of prior art references cited by the defendants are discussed. Since this document contains relevant operative facts to this lawsuit bearing on the patent owner's position of the meaning of its patent claims as expressed in briefs filed with courts in prior terminated litigation, the original filed with the court will be produced, but in lieu thereof, this draft will be produced. Although this document is clearly work product, the privilege will not be honored.

Cat. 10, No. 623 (French): This is an unsigned, undated, six-page document entitled "Technical Note" from Mr. Marconnet in the Scragg case. Mr. Marconnet is a French avocat representing Chavanoz. This document discusses the novelty of the Chavanoz patents, a patent owned by British Celanese, Ltd., Chavanoz French patent No. 1,053,338 and the two patents of addition thereto. This document is clearly work product but the privilege will not be honored because it contains operative facts relevant to this litigation on the patent owner's knowledge of the prior art and its position on its interpretation of its patent claims expressed in prior terminated litigation. The document will be produced.

EXCERPTS FROM THE DESCRIPTIONS OF DOCUMENTS IN ISSUE SUPPLIED BY THE DISTRICT COURT IN ITS OPINION OF FEBRUARY 5, 1974

Cat. 2, Doc. 211 (French): Six-page document without any given author, without any given addressee, without any date. A discussion of twist and false twist in the case of Chavanoz v. Universal Winding, now known as Leesona Corporation. This appears to be an expert's report. It contains relevant operative facts as to the patent owner's knowledge of the prior art. These operative facts were apparently gathered by a non-lawyer. They are relevant, may lead to admissible evidence and are under the exclusive control of the party resisting discovery. Although this document is work product the privilege will not be honored.

Cat. 3, Doc. 211 (French): This is a reply to the memorandum of Universal Winding, now Leesona Corporation, whose memorandum was originally dated 25 July 1959 in reply to a Chavanoz memorandum of 12 March 1959. This document is three pages long. It is lirected to the experts of the French court. On the last page there is a hand-drawn line indicating the transposition of one phrase. On the last line of the last page, it says "Paris, 1959" with a blank space for the exact date. This may or may not be a draft. There is no indication whether or not this document was filed with any French tribunal. However, because of the good condition of these three pages this court assumes that a document of similar nature, if not this document itself, was, in fact, filed with some tribunal. This court is also assuming that the document filed with the tribunal is in all the essential respects the same as this "draft" that was taken from the Chavanoz litigation files. This document contains relevant operative facts bearing on the patent owner's position on the meaning of the patent claims. Even though this document is work product the privilege will not be honored. A copy of the original filed with the court will be produced but in lieu thereof this document will be produced.

Cat. 3, Doc. 212 (French): A 14-page brief for Chavanoz in the case of Chavanoz v. Universal Winding, now Leesona Corporation, and Lainiere de Roubaix. It is unsigned but the first page bears the stamp of Alain le Tarnec, an Avocat in Paris. It is unsigned but it begins with the heading "May It Please The Court". On page 12 there are two handwritten additions of two French words. It is addressed to the President and the counsellors of the chamber of the Court of Appeals at Douai. On its face there is a strong indication that this document was filed with a French tribunal. In the absence of any evidence to the contrary by the patent owner, the document will be produced. Even though this document is work product, its filing with the court makes it a public record for which a work product privilege cannot attach.

Cat. 3, No. 415 (French): A 17-page memorandum in the case of Leesona v. ARCT, dated 28 September 1961. There is an illegible signature at the end but in the upper lefthand corner of the first page there is a notation that this document was prepared by the conseil en brevets, Leo Soep, now deceased. It contains a discussion of the validity and infringement of three French patents. It does not appear to have been filed with any court. There are a number of handwritten notations in the margins. This document is clearly work product but because it contains operative facts of the patent owner's knowledge of the prior art, known only to a witness, no longer available because of death, the work product privilege will not be honored. The document will be produced.

Cat. 3, No. 416 (French): This is a 4-page document with the heading, Leesona Corporation v. ARCT, dated December 12, 1961. It is signed by Leo Soep, now dead. It discusses the validity of two French patents. This document does not appear to have been filed with any court. It is clearly work product, but it contains operative facts as to the patent owner's knowledge of the prior art, known only to a witness no longer available because of death. Therefore, the work product privilege will not be honored. Furthermore, page 3 of this 4-page document is missing. The patent owner will produce it.

Cat. 3, No. 417 (French): A 4-page document prepared by Leo Soep, dated February 17, 1961, in the case of Leesona Corporation v. ARCT. It is entitled, "Addition to the Provisional Response of January 10, 1961, to the First Note of January 7, 1961". It does not appear to have been filed with any court. It contains a discussion of a meeting held on January 13, 1961, in the office of Mr. Rousselet, President of the College of Experts with the French court. It discusses remarks of the court experts on a French patent. This document is clearly work product, but since it contains operative facts on the patent owner's knowledge of the prior art, known only to a witness no longer available because of death, the privilege will not be honored. The document will be produced.

Cat. 3, No. 418 (French): A 3-page document prepared by Leo Soep, dated January 10, 1961, relating to Leesona Corporation v. ARCT. It is entitled, "Provisional Response to the First Note dated January 7, 1961". This is the document apparently referred to in the document known as No. 417. This document also discusses a French patent. It was not filed with the court apparently. It is clearly work product but since it contains operative facts as to the patent owner's knowledge of the prior art, known only to a witness no longer available because of death, the privilege will not be honored. The document will be produced.

Cat. 3, No. 533 (French): A 2-page document prepared by Leo Soep in Paris, dated June 20, 1957. Its heading is, "Technical Note". It was prepared in connection with Chavanoz' suit against Bonneterie Cevenole and Ernest Scragg and Co. The document discusses a French patent owned by Chavanoz which the two parties are accused of infringing. This document is clearly work product. This document contains operative facts gathered by a non-lawyer that are relevant and may lead to admissible evidence and are in exclusive control of the party resisting discovery. The relevant operative fact is the patent owner's prior position as expressed in this technical note involving a U. S. version of this French patent now involved in this suit. Since this operative fact is known only to a witness no longer available because of death, the work product privilege will not be honored, and the document will be produced.

Cat. 3, No. 535 (French): A 14-page document prepared by Leo Soep in Paris, dated March 23, 1959. It is entitled, "Technical Note, Chavanoz v. Bonneterie Cevenole, Cevennes and Ernest Scragg, Ltd." It contains the history of the French patent owned by Chavanoz in suit and two patents of addition. There is also a discussion of documents and foreign patents cited in opposition to the main French patent and its two additions. This document was not prepared for a court and is clearly work product but contains operative facts as to the patent owner's knowledge of the prior art known only to a witness no longer available because of death. Therefore, the document will be produced.

Cat. 11, No. 94 (French): This is a one-page memorandum from Leo Soep, dated April 11, 1964. Copies are addressed to Chavanoz, DAPID and ARCT. It concerns his observations on the Klinger experiment. This document is clearly work product, but since it contains relevant operative facts on the patent owner's position on the meaning of its patent claims, known only to a witness no longer available because of death, the privilege will not be honored.

Cat. 11, No. 325 (English): A 3-page document prepared by Mr. Leo Soep with copies sent to J. A. Kemp and Company, the British patent agents, Chavanoz, DAPID and ARCT. It is dated July 2, 1969 in Paris and has the heading Chavanoz and ARCT v. Klinger. It discusses British Patent No. 745,337. This document contains an analysis of prior art patents raised by Klinger in the infringement action brought by Chavanoz. This document is clearly work product, but since it contains relevant operative facts on the patent owner's knowledge of the prior art known only to a witness no longer available because of death, the document will be produced.

Cat. 11, No. 551 (French): This is a 32-page unsigned document. Assistant Counsel for the patent owner admits that he penciled in in English the word "draft" in the upper righthand corner of the first page. The first paragraph on the first page indicates that this document was involved in the case of Chavanoz v. Lainiere de Roubaix and Universal Winding Company, now Leesona Corporation. The document is unsigned and undated but indicates that it relates to the infringement action against the two defendants on the patent owner's French patent No. 1,054,338 and the two patents of addition. The second paragraph on page one indicates that the document is directed to the President of the Civil Tribunal of Lille, France. In the middle of the first page is the heading that says, "Oral argument in favor of infringement". The document is unmarked throughout. The document starts with the history of the invention on page 3, the history of the patents of addition obtained by the patent owner starting at page 9, the opposing arguments of the defendants starting on page 16, and the statement as to how there is an infringement in law by Universal Winding Company starting at page 28. The last page is entitled, "Prayer For Relief". On the basis of the foregoing description, the court is compelled to assume that this document was in fact filed with the French tribunal or at least that a document in all essential respects was so filed. Therefore, although this document is clearly work product, the fact that it was published with a court of law removes any privilege that may attach. A copy of the document for which this document is purportedly a draft shall be produced and in the event that such document is not produced, then this document shall be produced in lieu thereof.

Cat. 11, No. 552 (French): This is an 11-page document addressed to the President and Judges composing the tribunal at Lille. It is unsigned and undated. The heading at the top of the first page in capital letters says, "Conclusions of the Experts For Chavanoz Plaintiff against Universal Winding Company and Lainiere de Roubaix Defendants, May It Please The Tribunal". There are two handwritten additions. It first appears in the title behind the term Universal Winding and makes a reference to Leesona Corporation. The second appears on page 10. The body of the document starting at page 2 makes a reference to French Chavanoz patent No. 1,054,338 and two patents of addition. On its face this document appears to be a brief filed with a French court or at least a draft of such a brief. This court is compelled to assume that a document of similar nature was in fact filed or at least a document in all essential respects. Since the work product privilege cannot attach to any document made public through a filing with a court, a copy of the document submitted to the court at Lille shall be produced. In the event that such a document is not produced, then this document shall be produced in lieu thereof.

Cat. 11, No. 553 (French): This is a 7-page document entitled, "Conclusions for Chavanoz, the Plaintiff, against Universal Winding Company and Lainiere de Roubaix, Defendants, May It Please The Tribunal". Unlike some of the earlier documents examined, this one appears to be clearly a draft of a brief since there are about one-half dozen additions in the margins and delineations in the text. This document is unsigned and undated. It discusses infringement by the two defendants of Chavanoz French Patent No. 1,054,338, and its two patents of addition. Since this document was apparently not filed with the court, Chavanoz will produce the original filed with the court, or in lieu thereof, this document will be produced because it contains relevant operative facts as to the patent owner's position on the meaning of its patent claims in prior terminated litigation.

Cat. 10, No. 85 (French): This is the only document that this court takes up sua sponte. It is an expert's report prepared for Chavanoz in the Klinger litigation. It has the signature of Mr. Marcannet, a French avocat, at the bottom. The document discusses French patents owned by Chavanoz involved in the litigation. Since this document contains relevant operative facts as to the patent owner's knowledge of the prior art as expressed in this technical expert's report involving counterparts of the patents now in suit, this document will be produced. Although such a document is ordinarily work product, the privilege will not be honored. The document will be produced.

Cat. 10, No. 217 (French): A 3-page document authored by Leo Soep and dated March 9, 1964 entitled, "Chavanoz v. Leesona Corporation". There are numerous handwritten changes made throughout the document. There is a discussion of prior litigation in the French courts between these two parties and reference is also made to Chavanoz French Patent No. 1,054,338 and the two patents of addition. This document is apparently a draft of an internal memorandum stating Mr. Soep's opinions, conclusions and legal theories. This document will be produced since it contains relevant operative facts as to the patent owner's motive and intent in the 1964 settlement agreement with Leesona.

Cat. 10, No. 397 (English): A one-page unsigned letter to Mr. Cannon, a British patent-agent with J. A. Kemp and Company in London. The letter is dated March 22, 1971, and relates to the Chavanoz v. Klinger litigation. The letter discusses the problem of registering an ARCT-Chavanoz license. Even though there is a heading that this letter refers to the Klinger litigation, this court cannot ascertain any mental impression, conclusion, opinion or legal theory for which work product privilege might attach. There is, therefore, an insufficient showing that this document is work product and thus no privilege attaches. The letter will be produced, the patent owner not having carried its burden of proof.

Cat. 10, No. 403 (French): A one-page letter from Mr. Leo Soep on Chavanoz' stationery to Mr. deMoncuit. The letter is dated January 17, 1964 in Paris and refers to the infringement action of Chavanoz against Leesona in the court at Douai. This document contains operative facts relevant to the patent owner's motive and intent in the 1964 settlement agreement with Leesona and should be produced, especially in view of the fact that Mr. Soep is dead and Mr. deMonçuit has consistently displayed a faulty memory in regards to this matter. The privilege of this document as work product will therefore not be honored. The document will be produced.

Cat. 10, No. 413 (French): This document is a report from Mr. Henri Crouzet to Mr. Leo Soep dated March 15, 1962 in Paris concerning the arguments of the experts in the case of Leesona v. ARCT. The report contains four pages of text, two pages of experimental results and eleven pages of graphs. This document contains relevant operative facts as to the patent owner's knowledge of prior art patents on machinery owned by Leesona and on the patent owner's interpretation of his own patent claims. Therefore, although this technical expert's opinion is work product the privilege will not be honored. The document will be produced.

Cat. 10, No. 554 (French): Three copies of a one-page document entitled, "Pleadings at Lille in the case of Chavanoz v. Leesona on March 15, 1961". It is signed by Mr. Leo Soep and apparently contains his mental impressions of the proceedings in that court. This is an internal memorandum that is clearly work product. However, it contains relevant operative facts as to the patent owner's knowledge of the prior art and as to its position on the meaning of its patent claims. Since these operative facts are known only to the witness Soep who is no longer available because of his death, the work product privilege will not be honored. The document will be produced.

Cat. 10, No. 574 (French): An extract from some notes of Mr. Leo Soep dated July 5, 1965. This one-page, three-paragraph paper is entitled, "Fluflon Limited". This document does not appear to have been prepared in anticipation of or in preparation for any particular litigation. It contains merely the present state of litigation against a number of accused infringers including Scragg and Debonair. As such the work product privilege cannot attach to this document because of the insufficient showing made by the patent owner in carrying the burden of proof. The document will be produced.

Cat. 10, No. 622 (French): This is a 6-page unsigned and undated document. There are two pages numbered "3". The heading at the top of the first page says "Conclusions for Chavanoz, Plaintiff, represented by Mr. Beaume; against, Ernest Scragg & Sons, Ltd., Defendant, represented by Mr. Uzan; Bonneterie Cevenole, Defendant, represented by Mr. Gabbeau; and Cevennes, Defendant, represented by Mr. Gabbeau, also. May It Please The Court". Page 2 and the second page numbered "3" contains a number of handwritten changes and marginal notes. This indicates to this court that this document is a draft. Because of the heading of the document, this court assumes that a document of similar nature was in fact filed with a French court. The court also assumes that the document that was filed is in all essential respects the same as this draft before the court now. This document discusses the French patent No. 1,054,338 owned by Chavanoz and its two patents of addition. Also, a number of prior art references cited by the defendants are discussed. Since this document contains relevant operative facts to this lawsuit bearing on the patent owner's position of the meaning of its patent claims as expressed in briefs filed with courts in prior terminated litigation, the original filed with the court will be produced, but in lieu thereof, this draft will be produced. Although this document is clearly work product, the privilege will not be honored.

Cat. 10, No. 623 (French): This is an unsigned, undated, six-page document entitled "Technical Note" from Mr. Marconnet in the Scragg case. Mr. Marconnet is a French avocat representing Chavanoz. This document discusses the novelty of the Chavanoz patents, a patent owned by British Celanese, Ltd., Chavanoz French patent No. 1,053,338 and the two patents of addition thereto. This document is clearly work product but the privilege will not be honored because it contains operative facts relevant to this litigation on the patent owner's knowledge of the prior art and its position on its interpretation of its patent claims expressed in prior terminated litigation. The document will be produced.

OPINION

The Duplax Corporation, *Appellee,*

v.

Moulinage et Retorderie de Chavanoz, *Appellant,*
Deering Milliken, Inc., et al., *Defendants.*

No. 73-1618.

UNITED STATES COURT OF APPEALS, FOURTH CIRCUIT.

Argued June 5, 1973.

Decided Oct. 23, 1973.

Before Bryan, Senior Circuit Judge, and Field and Widener, Circuit Judges.

Field, Circuit Judge:

We entertained this appeal upon the narrow question whether upon the termination of litigation the work product documents prepared incident thereto lose the qualified immunity extended to them under Rule 26(b)(3), Federal Rules of Civil Procedure,[1] and become freely discoverable in subsequent and unrelated litigation.

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[1] Rule 26(b)(3), Fed.R.Civ.P., reads as follows:

> *Trial Preparation: Materials.* Subject to the provisions of subdivision (b)(4) of this rule, a party may obtain discovery of documents and tangible things otherwise discoverable under subdivision (b)(1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by or for that other party's representative (including his attorney, consultant, surety, indemnitor, insurer, or agent) only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain substantial equivalent of the material by other means. In ordering discovery of such materials when the required showing has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation.

In this multidistrict patent-antitrust proceeding, resolution of this question is of vital importance with respect both to depositions and requests for production of documents.[2] The district judge initially concluded "that once the privilege attaches it remains regardless of the litigation in which discovery is sought." However, in the course of the extensive discovery proceedings he reconsidered his position and concluded "that (1) when a case in litigation is finally terminated; (2) by either a decision of the court or by settlement among the parties; (3) the work product privilege is also terminated; and (4) the work product of attorneys in the prior litigation is therefore subject to discovery in subsequent litigation." Recognizing the importance of his ruling the district judge certified his order for interlocutory consideration pursuant to 28 U.S.C. § 1292 (b) and we granted the appeal. We disagree with the conclusion of the district judge and reverse.

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[2] It appears to be conceded that the documents claimed by Moulinage et Retorderie de Chavanoz [hereinafter referred to as Chavanoz] to be work product were generated incident to (1) a series of lawsuits in the early 1960s in which Leesona Corporation claimed that United States patents owned by it were infringed by the sale and operation of machines manufactured by a licensee of Chavanoz, or (2) a series of proceedings in foreign countries relative to the validity and infringement of foreign counterparts to the Chavanoz patents here in issue. It is further conceded that each of these litigations was terminated prior to the commencement of the present case.

Counsel for appellant submitted to this court copies of three "illustrative documents," the first of which appears to be notes of a meeting attended by four representatives of Chavanoz, two French patent counselors, a British solicitor and a patent agent. The document states that the purpose of the meeting was to "discuss the possible mounting of an infringement action against Klinger Manufacturing Co. * * *," and such litigation was later instituted. The second document is a working draft, including handwritten notes, of a memorandum prepared by Leo Soep, patent counselor for Chavanoz, relative to infringement litigation between Chavanoz and Leesona. The third document is a legal opinion from an attorney specializing in antitrust matters directed to an attorney specializing in patent matters relative to litigation against Leesona Corporation then pending the District Court of Massachusetts.

From the time the Federal Rules were first adopted one of the most litigated questions relative to the scope of discovery has been the extent to which a party may obtain disclosure and inspection of the documents and information developed during the course of an opponent's preparation for trial. As a result of the flood of inconsistent decisions in this area, in June of 1946 the Advisory Committee on Rules proposed an amendment to Rule 30(b).[3] The Supreme Court did not adopt the proposed amendment but dealt with the problem in the landmark case of Hickman v. Taylor, 329 U.S. 495, 67 S.Ct. 385, 91 L.Ed. 451 (1947). In *Hickman* the Court recognized a qualified immunity for what it characterized as the "work product of the lawyer" and held that it was discoverable only upon a substantial showing of "necessity or justification."[4] Unfortunately, in the succeeding years the courts failed to apply the principles of *Hickman* in a definitive or uniform manner, and one court went so far as to state that the decision had opened a veritable "Pandora's box."[5]

With the decisions of the district courts going off in different directions, the Advisory Committee once again turned its attention to the troublesome subject of work product. In a preliminary draft in 1967, the Committee suggested a new Rule 26(b)(3) defining work product and allowing discovery thereof "only upon a showing of good cause therefor."[6] The proposal was roundly criticized especially by those who felt that the test of "good cause" would not provide sufficient protection for work product material, and it was suggested that the "badly tarnished good cause test of Rule 34" would lower the barrier set in *Hickman*. *See* Freund, Work Product, 1968, 45 F.R.D. 493, 495. Responsive to this widespread criticism the proposal was altered and finally cast in the form in which it was adopted by the Supreme Court in 1970. It is generally conceded that the new Rule reflects the rationale of *Hickman*, and Professor Wright characterizes it as "an accurate codification of the doctrine announced in the Hickman case * * *."[7]

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[3] Report of Proposed Amendments, June, 1946. Reprint, 5 F.R.D. 433, 456.

[4] 329 U.S. at 510, 67 S.Ct. 385, 91 L.Ed. 451.

[5] Viront v. Wheeling & Lake Erie Ry. Co., 10 F.R.D. 45, 47 (N.D.Ohio 1950).

There is, of course, nothing in the Rule itself that suggests a specific answer to the question before us, nor is there any indication in the Advisory Committee Note to Rule 26(b)(3) that the Committee gave any particular thought to this problem.[8] However, since the Rule tracks Hickman the answer must, primarily, be gleaned from that decision.

The theme of *Hickman* is succinctly stated in Mr. Justice Murphy's prefatory statement:

> "Examination into a person's files and records, including those resulting from the professional activities of an attorney, must be judged with care. It is not without reason that various safeguards have been established to preclude unwarranted excursions into the privacy of a man's work. At the same time, public policy supports reasonable and necessary inquiries. Properly to balance these competing interests is a deli-

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[6] Preliminary Draft of Proposed Amendments to Rules of Civil Procedure relating to Depositions and Discovery, November, 1967. Reprint, 43 F.R.D. 225.

[7] 8 Wright & Miller, Federal Practice and Procedure, p. 193.

[8] *See* Federal Rules of Civil Procedure, Amended Rules, March 30, 1970. Reprint, 48 F.R.D. 459, 497.

> cate and difficult task." 329 U.S. at 497, 67 S.Ct. 385, at 387, 91 L.Ed. 451.

And disapproval of *carte blanche* incursions is manifest in the now classic statement:

> "Were such materials open to opposing counsel on mere demand, much of what is now put down in writing would remain unwritten. An attorney's thoughts, heretofore inviolate, would not be his own. Inefficiency, unfairness and sharp practices would inevitably develop in the giving of legal advice and in the preparation of cases for trial. The effect on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served." 329 U.S. at 511, 67 S.Ct. 385, at 393, 91 L.Ed. 451.

[1] *Hickman* clearly stands for the principle that the integrity of the adversary process must be safeguarded in spite of the desirability of the free interchange of information before trial. Its overriding concern is that the lawyer's morale be protected as he performs his professional functions in planning litigation and preparing his case. This work product immunity is the embodiment of a policy that a lawyer doing a lawyer's work in preparation of a case for trial should not be hampered by the knowledge that he might be called upon at any time to hand over the result of his work to an opponent.[9] The concern of the Court for the integrity of the practicing bar was made crystal clear in the trenchant concurrence of Mr. Justice Jackson when he stated that "[t]he primary effect of the practice advocated here would be on the legal profession itself,"[10] and "[t]he real purpose and the probable effect

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[9] *See* Radiant Burners, Inc. v. American Gas Association, 207 F.Supp. 771, 776 (N.D.Ill.1962).

[10] Hickman v. Taylor, supra, 329 U.S. at 514, 67 S.Ct. 385, 395, 91 L.Ed. 451.

of the practice ordered by the district court would be to put trials on a level even lower than a 'battle of wits'."[11] Mr. Justice Jackson then proceeded to point out the practical and undesirable professional consequences that could result from such a broad concept of the discovery process.

[2] While, of course, the Court in *Hickman* was addressing itself to material obtained by an attorney incident to the litigation then in progress, the rationale is scarcely less applicable to a case which has been closed than to one which is still being contested. The decision was not in any manner based upon the rights or posture of the litigants vis-a-vis each other.[12] Such a basis was expressly disavowed.[13] Rather, the thrust of the decision was the qualified protection of the professional effort, confidentiality and activity of an attorney which transcends the rights of the litigants. This concern was reiterated in the final words of the *Hickman* opinion:

> "We fully appreciate the wide-spread controversy among the members of the legal profession over the problem raised by this case. (footnote ommitted) It is a problem that rests on what has been one of the most hazy frontiers of the discovery process. But until some rule or statute definitely prescribes otherwise, we are not justified in permitting discovery in

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[11] *Id.* 329 U.S. 495 at 516, 67 S.Ct. 385, at 396, 91 L.Ed. 451.

[12] In *Hickman* the Court recognized that the materials sought fell outside the scope of the attorney client privilege. That privilege is for the protection and benefit of the client and not of the attorney. On the other hand, the attorney "work product" privilege is traditionally a privilege of the attorney and not of the client, and it has been held that waiver of the attorney-client privilege does not constitute a waiver of an objection that the information falls within the qualified immunity from discovery provided by the work product rule. Vilastor-Kent Theatre Corp. v. Brandt, 19 F.R.D. 522 (S.D.N.Y.1956); Developments in the Law, Discovery, 1961, 74 Harvard Law Review 940-1044, 45.

[13] 329 U.S. at 507, 67 S.Ct. 385, 91 L.Ed. 451.

> a situation of this nature as a matter of unqualified right. When Rule 26 and the other discovery rules were adopted, this Court and the members of the bar in general certainly did not believe or contemplate that all the files and mental processes of lawyers were thereby opened to the free scrutiny of their adversaries. And we refuse to interpret the rules at this time so as to reach so harsh and unwarranted a result." 329 U.S. at 514, 67 S.Ct. 385, 395, 91 L.Ed. 451.

This is strong judicial language and we find no indication that the Court intended to confine the protection of the work product to the litigation in which it was prepared or to make it freely discoverable in a subsequent law suit.[14]

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[14] The Court in *Hickman* adverted to the English concept of "professional privilege," 329 U.S., n. 9, p. 510, 67 S.Ct. 385, 91 L.Ed. 451. In England the privilege, which includes all documents prepared by or for counsel in pending or anticipated litigation, is recognized in subsequent litigation as well as the law suit in which it is prepared. Lord Justice Bowen in Lyell v. Kennedy, 27 Ch.Div. 1 (C.A.1884), stated the basis of the English privilege:

> "Then comes the point as to documents, and as to the documents, I agree with everything that has been said by the Lord Justice. We are not dealing now with documents which the party has procured himself: we are dealing with documents which have been procured at the instigation of a solicitor; and, bearing in mind the rule of privilege which the law gives in respect of information obtained by a solicitor, it seems to me we cannot make the order asked for by Mr. MacClymont without doing very serious injustice in this case. A collection of records may be the result of professional knowledge, research and skill, just as a collection of curiosities is the result of the skill and knowledge of the antiquarian or *virtuoso*, and even if the solicitor has employed others to obtain them, it is his knowledge and judgment which have probably indicated the source from which they could be obtained. It is his mind, if that be so, which has selected the materials, and those materials, when chosen, seem to me to represent the result of his professional care and skill, and you cannot have disclosure of them without asking for the key to the labour which the solicitor has bestowed in obtaining them."

In Pearce v. Foster, 15 Q.B. Div. 114 (C.A.1885) the documents sought had been prepared for use in an action which did not ul-

To so interpret *Hickman* would in our opinion elide the broad rationale of the Court's decision. Assuredly, the intrusion upon the attorney and the possibility of the demeaning professional consequences envisioned by Mr. Justice Jackson are just as objectionable in one case as the other. We are well aware of the divergent conclusions reached in similar cases [15] but in all deference we think that

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timately proceed. The court recognized that the documents fell within the scope of the privilege delineated in Lyell v. Kennedy, supra, and went on to state at page 119:

> "Then the question arises whether, assuming them to be within this privilege, the privilege is any the less applicable because in the present case the inquiries with regard to the documents are being made in an action other than that in regard to which they were originally brought into existence. I do not think, if they were privileged in relation to the first action, that the privilege ceases in relation to another action. The case of Bullock v. Corry (1) seems to me to be an authority for that conclusion, and the judgment of Cockburn, C. J., in that case, lays down a most valuable principle on this subject. There the documents in question were being inquired about in a different action from that in relation to which they originally came into existence, and the Lord Chief Justice said: 'The privilege which attaches by the invariable practice of our Courts to communications between solicitor and client ought to be carefully preserved. In my opinion the rule is, once privileged always privileged. This will apply à fortiori where the succeeding action is substantially the same as that in which the documents were used.' "

[15] *See* Tobacco & Allied Stocks, Inc. v. Transamerica Corp., 16 F.R.D. 537 (D.Del.1954); Hanover Shoe, Inc. v. United Shoe Machinery Corp., 207 F.Supp. 407 (M.D.Pa.1962); Honeywell, Inc. v. Piper Aircraft Corp., 50 F.R.D. 117 (M.D.Pa.1970). *Cf.* Insurance Company of North America v. Union Carbide Corp., 35 F.R.D. 520 (D.Colo.1964); LaRocca v. State Farm Mutual Automobile Insurance Co., 47 F.R.D. 278 (W.D.Pa.1969). *See also* Republic Gear Co. v. Borg Warner Corp., 381 F.2d 551 (2 Cir. 1967).

In some cases the courts have held that documents prepared for one case are protected in a second case only if the two cases are "closely related." In our opinion to dispose of this delicate and important question by such a technical touchstone is incompatible with the essential basis of the *Hickman* decision.

those courts which permitted unqualified disclosure misread the basic teaching of *Hickman.*

[3] On balance, we think the legal profession and the interests of the public are better served by recognizing the qualified immunity of work product materials in a subsequent case as well as that in which they were prepared, and this in our opinion comports with the statement in *Hickman:*

> "But the general policy against invading the privacy of an attorney's course of preparation is so well recognized and so essential to an orderly working of our system of legal procedure that a burden rests on the one who would invade that privacy to establish adequate reasons to justify production through a subpoena or court order. That burden, we believe is necessarily implicit in the rules as now constituted." 329 U.S. at 512, 67 S.Ct. 385, at 394, 91 L.Ed. 451.

Our decision will not in any way frustrate the ends of justice. If the party seeking discovery can demonstrate the substantial need and undue hardship specified in the Rule and recognized in *Hickman,* the district court will order production.[16] We think it appropriate and desirable that the district judge determine whether a party has made a showing sufficient to justify such an intrusion upon the privacy of an attorney's files.[17]

The order appealed from will be reversed and we remand to the district court for further consideration consistent with this opinion.

Reversed and remanded.

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[16] In their brief counsel for appellee contend that they had satisfied the "substantial need" and "undue hardship" requirements of Rule 26(b)(3). This issue is not properly before us on this interlocutory appeal and we express no opinion on this phase of the controversy. This, of course, is a matter which properly should be considered and determined by the district judge upon remand.

[17] *See* 8 Wright & Miller, Federal Practice and Procedure, p. 202.

ORDER

THE DUPLAN CORPORATION, *Plaintiff.*

v.

DEERING MILLIKEN, INC., ET AL., *Defendants.*

DEERING MILLIKEN RESEARCH CORPORATION, *Plaintiff.*

v.

THE DUPLAN CORPORATION, and Burlington Industries
Inc., *Defendants.*

THE DUPLAN CORPORATION ET AL.,
Plaintiffs on the Counterclaim,

v.

DEERING MILLIKEN RESEARCH CORPORATION,
Defendant on the Counterclaim,
and
DEERING MILLIKEN, INC., ET AL.,
Additional Defendants on Counterclaim.

Civ. A. Nos. 71-306, 70-968 and 69-1096.*

UNITED STATES DISTRICT COURT, D. SOUTH CAROLINA
SPARTANBURG DIVISION.

May 9, 1973.

Stay Denied May 17, 1973.

IN CAMERA INSPECTION OF DOCUMENTS SUBMITTED FEBRUARY 8, 1973, BY CHAVANOZ FOR WHICH THE ATTORNEY CLIENT AND/OR ATTORNEY WORK PRODUCT PRIVILEGE IS CLAIMED

HEMPHILL, District Judge.

The court has before it for *in camera* inspection six hundred eighty-three (683) documents (as well as one hundred sixteen (116) photographs and one hundred seventy-six (176) pages of reports of experiments, all claimed by producers as prepared in anticipation of litigation) production of which is sought by the Duplan Corporation and Burlington Industries (hereinafter referred to as the Throwsters) and withheld by Moulinage et Retorderie de Chavanoz (hereinafter referred to as Chavanoz) on claims of attorney-client privilege and/or work product privilege. The great majority of these documents have only one of these privileges claimed, although some have both claims made for them.

An initial *in camera* inspection of these documents, primarily for the purpose of more complete identification, was made by the court on March 5th, 6th and April 2, 1973. At that time counsel for Chavanoz identified the specific privilege or privileges claimed for each document and the court assigned an identifying number to the document or documents (some documents consist of two or more separate pieces of correspondence or memoranda), and with several exceptions noted in the transcript, either ordered the document produced at that time or tentatively accepted the classification assigned by counsel for Chavanoz. As approximately two thirds of the documents examined are in French, an interpreter acceptable to all parties was present to assist the court and acted in this matter as an officer of the court. A deputy clerk of the court and the official court reporter were present, and all colloquy between counsel, court, interpreter (translator), et cetera, were recorded, preserved, and later transcribed.

Subsequent to the transcription of the initial inspection, copies of which were made available to all parties, the Throwsters submitted to the court a memorandum in which, based on the information contained in the transcript and the list of privileged documents previously submitted by Chavanoz, they divided the documents into twelve categories[1] predicated on the grounds upon which they contested the court's tentative assignment of privilege. This memorandum was followed by a memorandum from Chavanoz in which the contentions of the Throwsters were either rebutted or acceded [2] to the Throwster's contentions, the latter being signified by their agreement to produce the documents in question. The documents which Chavanoz has agreed to produce are:

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[1] See Appendix A.

Document #	Category	Document #	Category
52	II	216	III & IV
68	II	410	II
127	III & IV	515	VI
146	III	524	I
148	III	525	I

Due to the volume of material before the court the claimed privileges of work product and attorney-client will be considered separately in the interest of expediting the production of those documents which the court has determined not to be privileged. Part I of this order will therefore be limited to the claimed work product privilege, and Part II, to be filed separately at a later date, will consider the claimed attorney-client privilege.

PART I

The Work-Product Privilege

[1-5] Before entering into a detailed examination of the work-product privilege as it relates to this case, a few preliminary observations, are in order. Initially, it is important to bear in mind that the sole purpose of the work product privilege is, as was said in Thompson v. Hoitsma, 19 F.R.D. 112 (D.C.N.J. 1956), to protect the legal craftsman in the product of his labors and this privilege continues until the confidential nature of such work is destroyed by public use, as in court, or until the ends of justice other-

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[2] Chavanoz relented from its previous claim of privilege as to many documents.

wise require its termination. *Id.* at 114, 115. See also Transmirra Products Corp. v. Monsanto Chemical Co., 26 F.R.D. 572 at 578 (S.D.N.Y. 1960). Furthermore, unlike the attorney-client privilege which is, short of a waiver by the party asserting it, absolute, the work product privilege is a qualified privilege which may be pierced by a showing of good cause by the party seeking discovery. While the attorney-client privilege is clearly the privilege of the client, the work product privilege is that of the attorney, for as was so well stated in Scourtes v. Fred W. Albrecht Grocery Co., 15 F.R.D. 55 (D.C.N.D. Ohio E.D. 1953):

> * * * The purpose of the attorney-client privilege is to encourage full disclosure of information between an attorney and his client by guaranteeing the inviolability of their confidential communications. The 'work product of the attorney', on the other hand, is accorded protection for the purpose of preserving our adversary system of litigation by assuring an attorney that his private files shall, except in unusual circumstances, remain free from the encroachments of opposing counsel. *Id.* at 58.

Consequently, as was noted in *Transmirra,* supra, the protection afforded an attorney's work product is not affected by a waiver of the attorney-client privilege.

[6-8] It is important to note, also, that while the attorney-client privilege goes to all communications between an attorney and his client where the attorney is acting in his capacity as a legal advisor, the work product privilege is limited to situations in which the attorney's efforts were either in preparation for trial or in anticipation of litigation.[3] Furthermore, the probability that some particular litigation will occur must be substantial before a document may be deemed to be "in anticipation of litigation", Thomas Organ Co. v. Jadranska Slobodna Plovidba, 54 F.R.D. 367 (N.D.Ill. 1972). Therefore the mere fact that

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[3] Federal Rules of Civil Procedure, Rule 26(b)(3).

a particular action or a particular patent has a likelihood of bringing about litigation at some time in the future is not a sufficient showing. The probability must be substantial and the commencement of litigation must be imminent. Phrased another way, some particular litigation must be contemplated at the time the document is prepared. In Hogan v. Zletz, 43 F.R.D. 308 (N.D.Okla. 1967), a proceeding ancillary to a patent infringement action, it was held with respect to some fifty-five (55) documents prepared by personnel in a corporate patent department and for which the work product privilege had been claimed, that as there was no indication that any of the documents "were prepared or obtained in preparation for possible litigation *after a claim was recognized as having arisen*", *Id.* at 317 (emphasis added), they would not be work product, and should therefore be produced. On appeal, Judge Breitenstein in Natta v. Hogan, 392 F.2d 686 (10 Cir. 1968), upheld the lower court's order as to these documents with a single exception. In reaching its decision the court observed that with the exception of the single document which it held need not be produced, none of the documents were identified as having been prepared by any particular attorney. While on a first reading Judge Breitenstein's statement that "The work product claim cannot be brushed aside on the theory that the documents were not prepared for use in litigation" *Id.* at 693, could give the appearance of having reversed the trial court's holding on this point, on close reading it is clear that this is not the import of the above quoted statement. In pertinent part the opinion provides:

> . . . The trial court held that the documents were not within the work product doctrine because they were not prepared "for possible litigation after a claim was recognized as having arisen."
>
> To support the reasoning of the trial court, Montecatini relies on Zenith Radio Corp. v. Radio Corp. of America, D.Del., 121 F.Supp. 792, 795, where it is said:

> "Seldom, if ever, are patent department employees engaged in actual preparation for a trial of the required type." *This may be true but here some of the documents specifically refer to the interference proceedings. Nothing in Hickman v. Taylor suggests that the work product rule is limited to preparation for proceedings in a court of record.* The rationale for the work product doctrine is the prevention of unnecessary interference with the work of an attorney. An attorney's work in the patent law field should be as much his own as it is in other areas of the law. The work product claim cannot be brushed aside on the theory that the documents were not prepared for use in litigation. *Id.* at 693.

Thus it is clear that the true import of this holding is that the work product privilege may be claimed for material prepared for administrative proceeding, such as patent interference proceedings *as well as* for proceedings before courts of record. Thus the trial courts requirement that there be some *particular litigation* contemplated was modified only to the extent that litigation was held to include patent interference proceedings. The single document which was excluded from production was excluded for the purpose of protecting the mental impressions, conclusions, opinions, or legal theories of an attorney concerning the "litigation" patent interference action). Where however, the author of similar documents in question was not identified, the order for production by the trial court was affirmed.

[9] The primary contention of the Throwsters, in the present proceedings to require production of the documents in question, is that the work product privilege affords protection to an attorney's efforts only so far as they concern the *current* litigation or proceedings. Put another way, it is their contention that the attorney's work product privilege terminates with the termination of the litigation toward which the attorney's efforts were directed.

Because of the potentially far-reaching effect of such an assertion as this, the court, aided by the very thorough briefs of counsel, has conducted an extensive examination of the precedents with respect to this question. The court is particularly mindful of the recent decision of Judge Atkins in Celanese Corp. and Fiber Industries, Inc. v. Leesona Corp., (M.D.L. Docket No. 82, No. 71-1026-CIV-CA, filed March 22, 1973), and this court's own order in Duplan Corp. v. Deering Milliken, et al (Consolidated Civil Action No. 71-306, Jan. 5, 1972), both of which held that the work-product privilege, once it attaches, remains regardless of the litigation in which discovery is sought. This court noted in *Duplan*, supra, at page 3, note 2, that to hold that the work product privilege terminates with the termination of the litigation to which it applied may well be a Pandora's box which the court must approach with extreme caution.

The earliest case this court has found which specifically considers the question of termination of the work product privilege is Tobacco and Allied Stocks v. Transamerica Corp., 16 F.R.D. 534 (D.Del. 1954) [hereinafter referred to as *Transamerica*]. The court in *Transamerica* was concerned with a claim of privilege for some twenty (20) letters contained in the files of an attorney which related to the availability of evidence obtained from outside sources for use in an earlier case, and which had been previously identified as work product for use in the prior case. Having first determined that these letters did not fall within the attorney-client privilege, the court squarely faced the question here under consideration. In concluding that the letters were no longer protected by the work product privilege the court observed:

> Moreover, the documents called for by the subpoena duces tecum are not protected from discovery by the "work-product" theory. Deponent has already testified he had never been retained as counsel to represent plaintiffs in the instant action prior to the decision of

> this Court in Speed v. Transamerica Corp., D.C.Del., 99 F.Supp. 808, on August 8, 1951. His correspondent, in connection with the 20 challenged writings, likewise never represented plaintiffs. It appears all of the correspondence now before the Court was a part of the files dealing with the Geller case and used in the preparation of that case for presentation to this Court. *In no sense can these letters—all written in 1943 and more than 8½ years prior to the institution of the case at bar—be a part of plaintiffs' attorneys' 'work-product' in the presentation [sic] of the instant case for presentation to this Court. Defendant, here, seeks not to obtain benefit of the present plaintiffs' counsels' industry in the preparation of the case at bar for trial. On the contrary, defendant seeks to obtain discovery of facts from which to ascertain what knowledge plaintiffs had in fact and are chargeable with in the instant case. Id.* at 537 (emphasis added).

The next case to directly consider this question was Hanover Shoe, Inc. v. United Shoe Machinery Corp., 207 F. Supp. 407 (M.D.Pa. 1962), [hereinafter referred to as *United Shoe*]. In United Shoe the document sought was a memorandum made in 1950 at a meeting as a part of United's defense to a Sherman Act violation alleged by the government. This case terminated in the trial court in 1953 and was affirmed by the Supreme Court in 1954. United argued that the memorandum formed a part of the attorney's work product in the prior case, and that since plaintiff's claim was founded on the adverse decision against defendant in the prior case, the memorandum was a part of the lawyer's work product in the prior action. In answering defendant's contentions the court held:

> The cases of Hickman v. Taylor, 1947, 329 U.S. 495, 67 S.Ct. 385, 91 L.Ed. 451 and Schwabe v. United Shoe Machinery Corp., E.D.N.Y. 1960, 26 F.R.D. 228, cited by the defendant in support of its work product argument are not controlling.
>
> *There is nothing in the Hickman case which extends the work product principle to preclude discovery of a*

> *lawyer's memorandum, prepared during a prior case, in a subsequent action between different parties.* *Id.* at 410 (emphasis added).

A case heavily relied upon by Chavanoz in opposing production of prior work documents is Insurance Co. of North America v. Union Carbide Corp., 35 F.R.D. 520 (D.Colo. 1964) [hereinafter referred to as *Union Carbide*]. In *Union Carbide* the court was considering *in camera* the defendant's attorney-client correspondence file relating to a prior closely related case. In its opening remarks the court observed that it had previously ordered production of certain correspondence between three law firms which was related to the prior litigation. The court stated that some of this correspondence might have involved work product; but that

> Inasmuch as the interests of the two separate defendants in the Montrose County action were potentially adversary, however, probably leading their attorneys to deal at arm's length, and since the communications between the law firms were not privileged, it was concluded that the interest of the Insurance Company of North America in discovering what agreement, if any, was made between the three law firms with respect to dealing with the subrogation interest of the Insurance Company of North America in the Montrose County action outweighed the interest of Tilly & Skelton and Coit & Graham in withholding from disclosure their entire correspondence files because some evidence of their strategy might have been reflected in correspondence between them. *Id.* at 521.

While this appears to be similar to the action taken in *Hanover Shoe* and *Transamerica*, supra, in considering the attorney-client files presently before it, the court after discussing the necessity of a showing of good cause to require production of an attorney's work product in a current action stated:

> The rationale which compels that we be extremely reluctant to invade an attorney's files is scarcely less

> applicable to a case which has been closed than to a case which is still being contested. Adversary counsel in an active case obviously should not normally be free to force his opponent to reveal his strategy; *but neither should counsel in a closely related subsequent case, albeit between different parties in part, obtain carte blanche to examine an attorney's files in the former case.* Should discovery of an attorney's work product in a former case ever be generally or indiscriminately permitted counsel would undoubtedly feel constrained to leave unwritten and unrecorded many of their impressions and plans which they should feel free to reduce to writing. *Id.* at 522 (emphasis added).

The court in *Union Carbide* took note of the *Hanover Shoe* case as being the "single reported case"[4] which could arguably be relied on for the proposition that the work product in one case is routinely discoverable in a subsequent action between different parties. It went on however to conclude that *Hanover Shoe* did not stand for that as a general principle, apparently basing this conclusion in part on the fact that a single memorandum was there sought, and further that the memorandum contained the statement of a party which that party had no other means of obtaining.

In light of the fact that the court in *Union Carbide,* in refusing to require production of the correspondence sought, concluded that all of the documents came under the attorney-client privilege, as well as the fact that its prior (apparently unreported) order had in fact required what the court later disapproved of, convinces this court that this disapproval must be looked upon as mere dictum, and that if anything, it stands for the proposition that the simple fact that prior litigation has terminated is an insufficient basis to allow *carte blanche* access to an attorney's files by opposing parties in subsequent litigation.

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[4] This reference is difficult to understand as the holding in *Transamerica* was quoted in *Hanover Shoe.*

The second case relied upon by Chavanoz is the only case on point above the trial court level which this court has been able to find. That case is Republic Gear Co. v. Borg-Warner Corp., 381 F.2d 551 (2 Cir. 1967) [hereinafter referred to as *Republic Gear*]. *Republic Gear* was a proceeding to compel discovery of documents, prepared for prior litigation and in possession of New York attorneys, for use in a suit pending in Illinois. The court there held that the documents sought, which were held by a nonparty attorney who had represented Brazilian corporations in prior litigation, were protected from adversary disclosure in subsequent litigation both as attorney's work product and by attorney-client privilege where the corporations had not waived the latter privilege. A careful reading of this case reveals, however, that it does not in fact stand for the proposition that the work product privilege extends beyond the *termination* of the litigation for which the documents were prepared. As was observed by the court in *Republic Gear:*

> With reference to the documents shielded from discovery below as an attorney's "work product," we have found little authority as to whether the "work product" protection is restricted to materials prepared in connection with the very litigation in which the discovery is sought. *The few lower court decisions in which disclosure was compelled dealt with material prepared for use in prior proceedings which had been fully completed before discovery was requested,* see, e.g., Hanover Shoe, Inc. v. United Shoe Machinery Corp., 207 F.Supp. 407, 410 (M.D.Pa.1962); Tobacco & Allied Stocks, Inc. v. Transamerica Corp., 16 F.R.D. 534, 537 (D.Del. 1954). *Those cases are thus clearly distinguishable from the present case,* for here the broad purpose of the rule which is designed to encourage effective legal representation by removing counsel's fear that his thoughts and information will be invaded by his adversary if he records them would be defeated if Republic could gain access to Nattier's files by proceeding against a party Nattier did not professionally rep-

> resent but nevertheless a party involved in the same transaction in which Nattier's former clients were involved. And *here, of course, Nattier's former clients remain suitable. Id.* at 557 (emphasis added).

The latest case on point, other than Judge Atkins' recent unreported decision, supra, appears to be Honeywell, Inc. v. Piper Aircraft Corp., 50 F.R.D. 117 (M.D.Pa. 1970) [hereinafter referred to as *Honeywell*]. *Honeywell* was a patent infringement case in which defendants counterclaimed alleging misuse of patents and a conspiracy to monopolize the manufacture, use, and sale of the patented aircraft guidance system. Defendants sought discovery of materials prepared by counsel in connection with prior patent interference actions, a situation having a great similarity to the present case. The Court there held:

> Turning first to the "work product" objection, a review of plaintiff's Exhibit A discloses that many of the documents related to interference cases are dated in the 1940's to 1950's and early 1960's. All documents listed are prior to the dates of this suit. Many of the interference actions are indicated as having been terminated by settlement or agreement. There is no indication that any are still pending. Defendants were not parties to the interference actions. *An attorneys' memorandum in a prior case involving different parties does not have the protection of the "work product" principle.* 4 Moore, Federal Practice para. 26.23 [8.-3] at p. 1436 (2d ed.). Hanover Shoe, Inc. v. United Shoe Machinery Corp., supra; Tobacco & Allied Stocks, Inc. v. Transamerica Corp., D.Del.1954, 16 F.R.D. 534; Cf. Republic Gear Co. v. Borg-Warner Corp., 2 Cir. 1967, 381 F.2d 551. *There is no indication that the documents were prepared "with an eye toward litigation" involved in this suit.* The work product objection cannot prevail. *Id.* at 119 (emphasis added).

In addition to the cases directly on point there are several cases which are pertinent to the question before the court. In United States v. Kelsey-Hayes Wheel Co., 15

F.R.D. 461 (E.D.Mich.1954), a civil anti-trust action, the defendants sought to raise the attorneys' work-product privilege as to certain documents removed from corporate files by the government prior to commencement of the litigation. As the court had already determined that any privilege claimed had been lost by defendant's own actions in allowing the government to remove the records in question from its general files, where they had been placed with no special protection for their claimed confidential status, its remarks concerning attorney work product are dicta, but are still relevant to the present question. Having earlier observed that an attorney's work files, assembled in preparation for a lawsuit, were protected against discovery, the court observed:

> These documents appear to be memoranda of law or reports of conferences. Even if prepared in anticipation of litigation, *the documents must presently be part of the work files of an attorney before they are entitled to the protection of the work-product rule.* These particular documents were apparently circulated among the interested officials of Budd and *it does not appear that they resided in the patent counsel's work files when pulled by the Government's representatives.* They do not, therefore, qualify for the special protection afforded by that rule. *Id.* at 465 (emphasis added).

As was previously observed, the court in Thompson v. Hoitsma, 19 F.R.D. 112 (D.N.J.1956)), stated that the work product privilege continues "*till the confidential nature of such work product is destroyed by public use, as in court, or till the ends of justice otherwise require its termination.*" *Id.* at 115 (emphasis added). This holding was also adopted by the court in Transmirra Products Corp. v. Monsanto Chemical Co., 26 F.R.D. 572 (S.D.N.Y.1960), citing *Thompson,* supra.

In light of the above noted cases, it appears that while there is indeed a split in authority as to whether the work product privilege terminates with the termination of the litigation, the split is not as severe as Judge Atkins' order of March 22, 1973, supra, would indicate. It is the determination of this court that the clear weight of authority must be viewed as indicating that (1) when a case in litigation is finally terminated; (2) by either a decision of the court or by settlement among the parties; (3) the work product privilege is also terminated; and (4) the work product of attorneys in the prior litigation is therefore subject to discovery in subsequent litigation.

[10] The material of which the Throwsters here seek production is allegedly sought for the purpose of determining the prior knowledge of Chavanoz as to the validity or the invalidity of certain patents which Chavanoz asserts are being infringed by the Throwsters. With the exception of one group of documents which will be discussed separately, the documents before the court all relate to and were prepared for prior litigation that has been terminated. It is the decision of this court that the weight of authority noted above clearly indicates, and the demands of justice dictate, that the documents here considered be ordered produced if a suffocation of truth is to be avoided. Those documents in Categories II; III; VII; VIII; IX; X and XI which were prepared for prior litigation that has been terminated, and for which an attorney-client privilege is not also claimed, as hereafter set forth in Appendix B, will be delivered by the court from its *in camera* file to the Clerk for immediate distribution to counsel for the Throwsters. Additionally, the one hundred sixteen (116) photographs and the one hundred seventy-six (176) pages of reports shall be produced by Chavanoz for inspection and copying by the Throwsters not later than May 10, 1973, at the Court House in Rock Hill, S.C. As these reports and photographs have been separated by counsel for Chavanoz from the documents with which they may have been associated, prior to production counsel for Chavanoz shall reassociate or otherwise identify the photographs and reports to the files and/or documents of which they are a part.

For the present the court withholds judgment on those documents for which the attorney-client privilege, either alone or in conjunction with the work product privilege, has been asserted. The production of these documents will be further considered by the court and a determination made as Part II of this Order.

The court has been advised by Chavanoz that certain documents within Category IX, commencing with No. 624 and including all listed thereafter, were prepared for patent interferences proceedings *presently in progress* in Great Britain. As such these documents are not subject to production under the rationale of prior *terminated* litigation. The court therefore reserves judgment as to these documents for the present and they will not be produced at this time. A decision as to these documents will be made at the time the court considers the claims of attorney client privilege.

A third group of documents which will not be produced at the present time consists of those documents designated by the Throwsters as Category XII, and categorized as "Documents which the Throwsters are not contesting on the basis of the information contained in the transcripts." As it is not clear to the court whether the placing of these several hundred documents (many of which are in French) in Category XII constituted an abandonment of Throwsters' allegation that the work product privilege did not attach to these documents as they concerned prior terminated litigation, the court withholds judgment as to these documents at the present time. The Throwsters shall therefore have until May 15, 1973, to submit to the court a list of those documents in Category XII which they maintain should be produced under this Order. Should no such list be submitted to the court in Columbia, South Carolina, by 5:00 P.M., Tuesday, May 15, 1973, the court shall consider Throwsters' request for production of these documents to have been permanently abandoned.

And it is so ordered.

APPENDIX A

IN CAMERA INSPECTION OF DOCUMENTS—March, 1973

CATEGORIES ASSIGNED BY THROWSTERS TO DOCUMENTS ALLEGED NOT TO BE PRIVILEGED

I. The claimed attorney-client privilege was waived by the client.

II. Miscellaneous.

III. The claimed work product document was filed or published with a court.

IV. The claimed attorney-client privilege fails because of a disclosure to a third party.

V. The claimed attorney-client privilege and/or work product rule fails because the attorney was acting as a conduit.

VI. The claimed attorney-client privilege fails for want of confidentiality.

VII. The claimed attorney-client privilege and/or work product rule fails because of abuse of the privilege or the rule.

VIII. The claimed work product document post-dates the termination of the prior litigation.

IX. The claimed work product document was prepared for an opposition or other patent office proceeding which was not handled by a member of the bar.

X. The claimed work product document antedates the termination of the prior litigation.

XI. The claimed attorney-client privilege and/or work product rule fails because of an insufficient showing.

XII. Documents which the Throwsters are not contesting on the basis of the information contained in the transcripts.

Appendix B

Documents to be Produced Pursuant to This Order

Document Number	Categories
3	X
5	XI
6	X
25	X
26	X
27	II
44	X
45	X
46	X
52	XI
58	X
67	X
75	X
77	XI
85	X
87	X
88	X
89	X
90	X
93	XI
94	XI
95	XI*
96	XI
100	X
101	X
102	X
108	X
113	XI
116	VIII
121	VIII
209	X
211	III
212	III
213*	XI
217	X
220	XI
223	III; IV; X
225	X
226	X
227	X
229	X
230	X
231	X
232	X
233	X
235	X
236	X
237	X
239	X
242	X
243	X
244	X
246	X
247	X
248	X
249	XII
250	X
252	X
254	X
255	X

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* This document was not presented to the court for inspection.

DOCUMENT NUMBER	CATEGORIES
256	X
257	X
258	X
259	X
260	X
261	X
262	X
271	X
272	X
273	X
278	X
279	X
285	X
289	XI
290	X
306	X
309	XI
312	X
313	X
314	X
315	X
316	X
319	X
320	X
321	II
321	VIII
321	XI
322	II
322	VIII
322	XI
325	X; XI
326	X
329	X
333	X
335	X
336	X
337	X
340	X
341	X
342	X
343	X
344	X
345	X
346	X; XI
347	X
348	X
349	X
350	X
351	X
352	X
354	X
355	X
356	X
358	X
359	X
360	X
362	X
363	X
364	X
365	X
366	X
367	X
369	X
370	X
371	X
372	X
373	X
374	X
375	X
376	X

DOCUMENT NUMBER	CATEGORIES
377	X
378	X
380	X
381	X
387	X
389	X
397	X
399	X; XI
400	X; XI
401	II; VII VIII; XI
403	X
404	X
405	X
406	X
411	X
413	X
414	X
415	III; X
416	III; X
417	III; X
418	III; X
423	VII
443	VII
457	VII
459	VII
461	VII
465	VI; X
482	X
501	X
526	XI
527	X; XI
528	X
532	X
533	III
534	III
535	III
537	X
538	X
539	X
540	X
541	X
542	X
543	X
544	X
545	X
546	X
547	X
549	II; X
550	X
551	X; XI
552	X; XI
553	X; XI
554	X
574	X
575	X
576	IX; X
577	IX; X
578	IX; X
579	IX; X
580	IX; X
581	IX; X
591	X
592	X
594	X
597	XI
599	X
622	X
623	X

Note: During the initial *in camera* inspection conducted March 5, 6, and 12, 1973, only the work product privilege was claimed but subsequently an attorney-client privilege was claimed as well for the below listed documents. Consequently these documents will not be produced at this time, and will be considered further in Part II to this order.

DOCUMENT NUMBER	CATEGORIES	DOCUMENT NUMBER	CATEGORIES
467	VI;X	536	X
470	X	593	X

Document No. 215 was not placed in any category by Throwsters. As only the work product privilege is claimed for this document it will be produced.

ORDER DENYING MOTION OF CHAVANOZ FOR A STAY IN THE PRODUCTION OF DOCUMENTS ORDERED BY THE COURT'S ORDER OF MAY 9, 1973, AND PROTECTIVE ORDER RELATING THERETO.

ORDER

Counsel for Chavanoz, one of the defendants, (or plaintiffs) in this action, by motion filed May 17, 1963, but noted by telephone May 14, 1973, seek this court's order staying the production of documents previously ordered by this court's Order of May 9, 1973. Movant states that it, along with its co-defendants (or co-plaintiffs as the case may be) wish to explore the application of Rule 26(b)(3) to documents prepared or obtained in connection with terminated litigation, and seek a ruling from the United States Court of Appeals for the Fourth United States Judicial Circuit on the issue of the application of the rule to work product documents ordered produced under the May 9 order. After the order of May 9 was published, counsel for Chavanoz asked that the effective date of the production be suspended until May 14, 1973, in order that they might review the language of the order and make a determination as to what procedure they would employ in view of the rulings published. Subsequently, on May 14, 1973, at the instigation of Stephen Finell, Esquire, counsel for Chavanoz, a conference call was arranged in which the parties were Stephen Finell, Esquire, Mr. Fletcher C. Mann, Esquire, O. G. Calhoun, Esquire, Tom Legare, Esquire (Law Clerk for the Court), and the Court. At the time, the Court advised counsel that rather than attempt to attend to business by telephone the motion should be reduced to writing, and arrangement was made for the court to return to Rock Hill on May 17 for a hearing set at 10:00 A.M. o'clock in the courtroom.

The colloquies pursued in the hearing were reduced to Stenotape by the official court stenographer, for further review of such higher authority as might wish to review the arguments presented, and will be transcribed today.[1] Because the application over the telephone came at a time when the court had made arrangements to attend a professional meeting (A. L. I.) in a distant city, and had released certain members of the staff for vacation, the court was unable, within the time spectrum presently before us, to immediately reduce this to a formal written order. This order was therefore dictated from the bench in open court, transcribed, edited and now is published in written form.

Rule 8 of the Federal Rules of Appellate Procedure provides in subsection (a) in part: "Application for a stay of the judgment or an order of the district court pending appeal, or for approval of a supersedeas bond, or for an order suspending, or modifying, restoring or granting an injunction during the pendency of an appeal, must ordinarily be made first in the District Court. A motion for such relief may be made to the Court of Appeals or to a judge thereof, but the motion shall show that the application to the district court for the relief sought is not practical, or that the District Court has denied an application, or has failed to afford the relief which the applicant requested, with the reasons given by the District Court for its action."

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[1] The court stenographer was directed to give priority to the colloquies and order of the hearing.

[11] Chavanoz very properly presented the issue to this court in the first instance. Other parts of the motion, treated here only for the purpose of placing it on record involved documents 229 through 320, as numbered and identified in the order of May 9, 1973; by oral order issued from the bench this day determination of the issues presented as to those documents has been delayed until counsel could offer written support of their respective positions. Likewise, Chavanoz moves to amend the order of May 9, 1973 by deleting document numbered as 423 from the Appendix B of the May 9 order for the reasons stated in the motion. As to that document, counsel have agreed that production should be withheld pending written brief or advices from respective counsel, on the issues thereabout.

This court does not have the authority to preempt, excite, participate, or in any way schedule any appellate review, whether by a single judge of the higher court (Fourth Circuit), or by a panel thereof, or by the full Court. This court takes judicial notice of the fact that the United States Circuit Court of Appeals for the Fourth United States Circuit is presently scheduled for a regular session of that court in June 1973 commencing on June 4. It is anticipated that thereafter the court will engage in its summer recess. Whether or not that Court would be able to afford a review of the issue presented by the motion at an August or September session is not for this Court to either predict or anticipate. Nor does this court have any knowledge as to the workload of that high tribunal. The reason for containing this in the order is because this court feels it must take cognizance of the prospect of delay in this case if the time factor is of the importance it previously has enjoyed in the colloquy between the court and counsel.

[12] Unfortunately, this is not a final decision as to any claim or major issue in this case which has so far been advanced, which would bring it directly under the provisions of 28 U.S.C. § 1291. The provisions of the 28 U.S.C. § 1292(a)(1) provides that

> "The court of appeals shall have jurisdiction of appeals from: the interlocutory orders of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court."

Mindful of the various decisions on piecemeal appeals, which may or may not have provoked the enactment of 28 U.S.C. § 1292, this court finds itself in the dilemma of being asked to stay its own ruling, which does not amount to enjoining its own ruling, but to a postponing of the effect of the same. If this Court's decision were final, or this Court had the right or authority to say whether or not an appeal from this order would be honored or heard by the Circuit Court, the situation presently presented would not be as difficult. Under the present posture of the case if this court denies a stay then there is no reason counsel cannot repair to a judge of the Fourth Circuit, or a panel of that high authority, or appear as that court might otherwise direct for such considerations, expedition or acceleration as that court might feel justified.

The record here has been transcribed, the documents are in the hands of the clerk and available, and this court has previously issued its opinion that the documents should be produced.

We face practical difficulties arising from the fact that previously this court had scheduled, with the consent of all parties, depositions to be conducted by the opponents of the motion commencing on or about July 9, 1973 and running thereafter two or three weeks as necessity might dictate. Tentatively, a trial date has been set for the first Monday in October (with the permission of the Chief Judge of the District of South Carolina), and scheduling plans have been issued to that effect. This is not controlling, but the fact remains that if the documents are produced as the order provided, counsel plan to conduct examinations during the depositions, on the basis of those documents produced in July as contemplated. It is easy to reason that if a stay is issued it will have the impact of denying access to those documents during those examinations, and if it be determined by higher authority that the production ruling of May 9 was correct, then the problem of (1) getting the witness back to this country for further deposition, (2) preserving the testimony in the event of some tragic happening to the witness, and (3), repeating much of the processing or examination which has previously been conducted, is obvious. On the other hand, if the United States Fourth Circuit Court of Appeals should determine that the order was incorrect, then the dilemma arises from the fact that the documents would have been produced and counsel would have seen the documents.

This court for the reasons stated herein, and for the reasons evident from the colloquy with counsel, refuses the stay at this level. If the documents are produced as directed by the order of May 9, and higher authority does not issue a stay, unless and until this or the higher court directs otherwise, all documents produced are subject to the following *protective order:*

(a) If the documents are produced, they shall be produced to a designated counsel of the opponents who shall be responsible to make those documents available only to such associate counsel as may need the documents for preparation or for deposition, and the court designates Fletcher C. Mann, Esquire as counsel for that purpose;

(b) If in his opinion, Mr. Mann thinks it necessary to duplicate any document in order to make the same readily accessible to any associate counsel, the document shall be numbered as Duplicate No. 1 or 2 as the case may be, and upon termination of the examination thereof, returned with the original document furnished to Mr. Mann, to the Clerk of this Court in order that the discovery processes may not be considered controlling as to the relevance of the documents or the *relevance* of the testimony incident to the documents upon the trial of the cause;

(c) Under no circumstances, and upon pain of contempt, shall any counsel to whom any document is produced allow any other person, firm, or corporation to review any document covered by this order except within the confines of this protective order;

(d) In the event the documents are used for examination of any witness, that examination shall be conducted, as to the contents of those documents, at the conclusion of the other examinations of the witness in question, and shall be in private and subject to such exclusions as may be necessary and as may be presented by counsel to the court when those examinations are imminent;

(e) Nothing herein contained shall be determinative of the relevance of any document so produced, and the issue of relevance may be raised at any appropriate time by any of the counsel involved;

(f) In the event documents are used under an excluded deposition, those portions of the deposition shall be sealed and given to the Clerk of the Court by the

> court stenographer then engaged, and the usual practice of circulation of transcripts of the depositions shall not be employed in those instances.

This court recognizes the right of Chavanoz to apply to higher authority, and in order that time may be given not only for the transcription of this record (which the court stenographer has been ordered to produce today in priority of all other matters in his hands) the production order of May 9 is delayed in impact until May 22, 1973 at 4:30 p.m.

This court has considered certification under 28 U.S.C. § 1292(b) which provides:

> "When a district judge, in making in a civil action an order not otherwise appealable under this section, shall be of the opinion that such order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation, he shall so state in writing in such order."

It is the considered judgment of the court that such section has applicability and that there is a controlling question of law. Under the procedure allowed under Rule 8, this court finds it unnecessary to further rule herein.

And it is so ordered.

No. 74-840

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IN THE

Supreme Court of the United States

October Term, 1974

THE DUPLAN CORPORATION, ET AL.,
Petitioners,

v.

MOULINAGE ET RETORDERIE DE CHAVANOZ,
Respondent.

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Fourth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

JAY GREENFIELD
Paul, Weiss, Rifkind,
Wharton & Garrison
345 Park Avenue
New York, New York 10022
(212) 644-8000
Counsel for Respondent

ROBERT S. SMITH
STEVEN FINELL
Paul, Weiss, Rifkind, Wharton & Garrison
345 Park Avenue
New York, New York 10022
Of Counsel

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IN THE

Supreme Court of the United States

October Term, 1974

No. 74-946

THE DUPLAN CORPORATION, ET AL.,
Petitioners,
v.
MOULINAGE ET RETORDERIE DE CHAVANOZ,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

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BRIEF FOR RESPONDENT IN OPPOSITION

Preliminary Statement

Petitioners seek review of an interlocutory order denying them discovery of 21 documents and ordering further consideration of those documents by the district court. The principal effect of such review would be substantial delay in the trial of 37 consolidated patent-antitrust cases, some of which have been pending for more than six years.

The court of appeals held that the district court had failed, in ordering production of the 21 documents, to "protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation" as required by Rule 26(b)(3) of the Federal Rules of Civil Procedure. In so holding, the court of appeals adopted an interpretation of this language that is compelled by the text of the Rule itself, and is consistent with every reported court of appeals and district court decision since the Rule was enacted in 1970. The holding of the court of appeals—that Rule 26(b)(3) confers unqualified immunity from discovery upon the mental impressions, conclusions, opinions, and legal theories of counsel and others—is not sufficiently doubtful or disputed to warrant review by this Court.

Even if this Court were disposed to consider whether the protection afforded by the second sentence of Rule 26(b)(3) is unqualified, this case is not an appropriate vehicle for such consideration, because the decision below may be supported on an independent ground.

Rule Involved and Decisions Below

Fed. R. Civ. P. 26(b)(3) is set forth at page 3 of the petition. The decisions below are annexed to the petition as an appendix.

Question Presented

Did the court of appeals err in holding that the district court's interlocutory order directing discovery of 21 documents failed to "protect against disclosure of the mental impressions, conclusions, opinions, or legal theories" of attorneys and other parties' representatives concerning litigation, as required by Fed. R. Civ. P. 26(b)(3), and in remanding the case to the district court for further consideration as to whether redacted or abstracted versions of the documents should be produced?

Statement of the Case

Respondent, Moulinage et Retorderie de Chavanoz ("Chavanoz"), is the owner of several United States patents on apparatus and processes for texturing yarns by the false twist method. Chavanoz has licensed Deering Milliken Research Corporation ("DMRC") to sublicense the use of the patented inventions in the United States.

Petitioners entered into patent license agreements with DMRC at various times. Beginning in 1968, petitioners stopped paying the agreed royalties. DMRC then commenced actions for breach of the license agreements and for patent infringement. Chavanoz was made a party by petitioners and has subsequently joined DMRC as a plaintiff. In answers and counterclaims, and in independent actions of their own, petitioners allege that DMRC, Chavanoz, and others have violated the antitrust laws, and that the patents in suit have been misused, are invalid, and are not infringed. In all, 37 actions involving Chavanoz were brought in four district courts: those originating elsewhere were transferred to the United States District Court for the District of South Carolina pursuant to 28 U.S.C. §1404, where the actions were consolidated.[1]

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[1] The first complaint was filed on August 8, 1968, and the most recent on March 29, 1971.

Extensive—indeed, seemingly endless—discovery and other pretrial proceedings have taken place. There have been 122 days of depositions, involving 78 witnesses, during which more than 2,000 pretrial exhibits were marked; over 1,000,000 documents have been produced; 16 sets of interrogatories and requests for admissions containing more than 350 separate questions or propositions have been served and responded to.

This petition arises from petitioners' attempt to obtain 21 more documents—all of which, it is undisputed, were prepared in anticipation of litigation or for trial and contain mental impressions, conclusions, opinions, or legal theories of attorneys or other representatives of Chavanoz.[2] The documents in dispute, which include legal memorandums, drafts of briefs, and the like were prepared for Chavanoz in connection with prior patent litigations in the United States and Europe.

The discovery dispute which petitioners seek to bring to this Court has a complex history of its own, beginning almost two years ago.

In an order filed May 9, 1973, the district court granted petitioners discovery of certain trial preparation materials, without regard to need or hardship; the district court held that the protection afforded by Fed. R. Civ. P. 26(b)(3) disappears when the litigation for which the materials were prepared is ended. *Duplan Corp.* v. *Deering Milliken, Inc.*, 61 F.R.D. 127 (D.S.C. 1973). On interlocutory appeal, this ruling by the district court was reversed by the Court of

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[2] The order below should control the district court's rulings on additional work product documents that are now under consideration.

Appeals for the Fourth Circuit, which remanded the matter to the district court for further consideration of whether petitioners had made the showing of substantial need and undue hardship specified in Rule 26(b)(3). *Duplan Corp. v. Moulinage et Retorderie de Chavanoz,* 487 F.2d 480 (4th Cir. 1973).

Petitioners sought and obtained an extension of 60 days within which to file a petition for certiorari seeking to review the court of appeals' 1973 decision. See No. A-684, Jan. 17, 1974. However, they never filed the petition.

On remand, the district court ordered production of some of the documents, and denied discovery of others in decisions dated December 21, 1973 and February 5, 1974.[3] However, in ordering production of some of these trial preparation materials the district court did not—and did not purport to—"protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation." The district court held that the Rule's protection of mental impressions, conclusions, opinions, and legal theories ("opinion work product," for short) does not apply to materials prepared for prior litigations, and that discovery of such matter is available in a subsequent action upon the same showing that will permit discovery of ordinary work product that does not contain opinion.

On a second interlocutory appeal, this ruling was reversed by the court of appeals in the order of which petitioners now seek review. Petition for Certiorari, at A1-A12. The court of appeals held that the immunity accorded to opinion work product by Rule 26(b)(3) is unqualified, and does not end as soon as the litigation for which the materials are prepared is over. The court of appeals again remanded the matter to the district court, directing it to produce discoverable material, if any, to the petitioners, but to protect against disclosure of mental impressions, conclusions, opinions, and legal theories. Redacting and abstracting the documents were suggested as possibilities. Thus, the court of appeals' order is not only non-final in the sense that it did not terminate the litigation; it did not even finally decide the discovery dispute.

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[3] Neither decision has been reported. A portion of the February 5, 1974 decision, which includes the district court's rationale with respect to the issue now in dispute, is reproduced in the Petition for Certiorari, at A14-A66.

Argument

Certiorari should be denied. Petitioners seek review of an interlocutory order which is clearly correct and is not in conflict with the decisions of this or any other court. There can be little doubt that opinion work product is immune from discovery under Rule 26(b)(3); but in any event, this is not the right case for this Court to consider this issue. The court of appeals decision can be sustained on the alternative ground that no circumstances here exist that even arguably justify discovery of opinion work product.

I

This case does not justify a departure from the usual rule against review of interlocutory orders on certiorari.

This Court does not grant certiorari to review interlocutory orders, absent extraordinary circumstances. *Firemen* v. *Bangor & A. R. Co.,* 389 U.S. 327, 328 (1967):

> "Petitioners seek certiorari to review the adverse rulings made by the Court of Appeals. However, because the Court of Appeals remanded the case, it is not yet ripe for review by this Court. The petition for a writ of certiorari is denied. See *Hamilton Shoe Co.* v. *Wolf Brothers,* 240 U.S. 251, 257-258 (1916)."

See *Goldstein* v. *Cox,* 369 U.S. 471, 487 (1970); *American Construction Co.* v. *Jacksonville, T. & K.W.R. Co.,* 148 U.S. 372, 384 (1893).

No extraordinary circumstances exist here. On the contrary, the already long delay in reaching trial, and the absence of a final ruling even on the discovery of materials contained in the 21 documents in issue, weigh heavily against granting this petition. To grant certiorari would impede progress of the litigation for many months, in order to consider a ruling whose impact on this litigation is still unresolved: that impact depends on what the district court does in response to the court of appeals' direction that it consider partial production, or the making of abstracts, of some of the documents, so that discoverable material, if any, will be produced to the petitioners.[4]

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[4] In addition to the 21 documents remanded to it for further consideration by the court of appeals, the district court still has before it a number of documents for which claims of privilege have been made and upon which it has not yet ruled.

II

The court of appeals decision is correct, and not in conflict with any decision of any other court.

Fed. R. Civ. P. 26(b) (3), promulgated in 1970, distinguishes between trial preparation materials that consist of opinion work product and those that do not. In the first sentence of the Rule, materials that do not contain opinion work product—for example, reports of witness interviews made in anticipation of litigation—are given qualified immunity, but will be discoverable

> "upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means."

In the second sentence, opinion work product is given unqualified immunity. Such work product is not discoverable even where substantial need and undue hardship have been shown:

> "In ordering discovery of such materials when the required showing has been made, the court *shall protect* against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation." (Emphasis added.)

A like distinction between opinion work product and other kinds of work product (*e.g.*, statements made by witnesses) is found in *Hickman* v. *Taylor*, 329 U.S. 495 (1947).

In *Hickman*, with respect to non-opinion work product, the Court wrote:

> "We do not mean to say that all written materials obtained or prepared by an adversary's counsel with an eye toward litigation are necessarily free from discovery in all cases. Where relevant and non-privileged *facts* remain hidden in an attorney's file and where production of those *facts* is essential to the preparation of one's case, discovery may properly be had." 329 U.S., at 511 (emphasis added).

On the other hand, the Court said that if the discovery rules were read to permit access to opinion work product,

> "An attorney's *thoughts*, heretofore inviolate, would not be his own. Inefficiency, unfairness and sharp practices would inevitably develop in the giving of legal advice and in the preparation of cases for trial. The effect on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served." 329 U.S., at 511 (emphasis added).

It is clear from *Hickman*, and still clearer from Rule 26(b)(3), that opinion work product must remain "inviolate."

In this case, the court of apepals, in a well reasoned opinion, did no more than to apply the distinction made in *Hickman* and in Rule 26(b)(3). Specifically, the court of appeals held that under Rule 26(b)(3), "no showing of relevance, substantial need or undue hardship should justify compelled disclosure of an attorney's mental impressions, conclusions, opinions or legal theories. This is made clear by the Rule's use of the term 'shall' as opposed to 'may.' " Petition for Certiorari, at A6.

As the court of appeals noted (Petition for Certiorari, at A8-A9), no case decided under Rule 26(b)(3) has reached a contrary conclusion. In accord with the court of appeals' decision are *Smedley* v. *Travelers Ins. Co.,* 53 F.R.D. 591, 593 (D.N.H. 1971); *Kennedy* v. *Senyo,* 52 F.R.D. 34, 37 (W.D. Pa. 1971); *Clower* v. *Walters,* 51 F.R.D. 288, 289 (S.D. Ala. 1970); *Crocker* v. *United States,* 51 F.R.D. 155, 156 (N.D. Miss. 1970). The court of appeals cited (Petition for Certiorari, at A8-A9) a number of pre-1970 cases which seemed to take a contrary view, but pointed out that most of the cases are distinguishable, and all are of doubtful authority, since they antedated Rule 26(b)(3). Indeed, a reading of the pre-1970 cases shows that only one, *McCullough Tool Co.* v. *Pan Geo Atlas Corp.,* 40 F.R.D. 490 (S.D. Tex. 1966), permitted discovery by an adversary of mental impressions concerning litigation.

The post-Rule 26(b)(3) cases relied on by petitioners are inapposite. *United States* v. *Brown,* 478 F. 2d 1038 (7th Cir. 1973), cited in the petition (at 13-14) for the proposition that there is a conflict in circuits, dealt with memorandums prepared to discuss the tax consequences of a contemplated business transaction. 478 F. 2d, at 1039. Since the memorandums were not prepared in anticipation of litigation or for trial, Rule 26(b)(3) was inapplicable to them. *Harper & Row Publishers, Inc.* v. *Decker,* 423 F. 2d 487 (7th Cir. 1970), aff'd by an equally divided Court, 400 U.S. 348 (1971), and *Xerox Corp.* v. *International Business Machines Corp.,* 64 F.R.D. 367 (S.D.N.Y. 1974), dealt with memorandums of witness interviews, the type of ordinary, non-opinion work product that is discoverable under Rule 26(b)(3) upon the required showing of substantial need and undue hardship. 423 F. 2d, at 492; 64 F.R.D., at 375.

For the reasons stated in the court of appeals decision, opinion work product is immune from discovery under Rule 26(b)(3), and the cases uniformly so hold. This proposition is not sufficiently doubtful or disputed to warrant review by this Court.

III

The decision below may be supported on an independent ground.

The decision below is supported by an independent ground, not reached by the court of appeals, that precludes this Court from considering the issues posed by petitioners. This ground is that the second sentence of Rule 26(b)(3) expressly affords protection to opinion work product that is not afforded to non-opinion work product; and neither court below found or had a basis for finding any facts that would enable petitioners to overcome that protection.

The district court did not find that petitioners had made any showing beyond the "substantial need" and "undue hardship" that would permit discovery of non-opinion work product—transcripts of interviews with witnesses, for example. The district court thought that no greater showing was required for discovery of the draft briefs and other opinion work product at issue here because, in the district court's view, the distinction between opinion and non-opinion work product was erased by the termination of the prior litigations for which the documents in dispute were prepared. In other words, the district court held that opinion work product is relegated to the status of non-opinion work product when a litigation ends. This holding ignores the difference between the first and second sentences of Rule 26(b)(3); it appears to be without support in the authorities; it was rejected by the court of appeals; and petitioners do not attempt to defend it here.[5]

Assuming, *arguendo,* that the second sentence of Rule 26(b)(3) does not mean what it says, and allows production of opinion work product upon a certain showing, such a showing must require more than what is necessary for the production of non-opinion work product under the first sentence of the Rule. Neither court below found that such a showing had been made; the petitioners do not claim to have made such a showing; and none can be found in the record.[6]

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[5] Petitioners have previously chosen not to argue in this Court that *all* work product immunity ends with the end of the litigation for which documents were prepared. This issue was resolved by the court of appeals in its prior decision (Petition for Certiorari, at A67-A75), from which petitioners did not seek certiorari.

Moreover, petitioners were clearly correct in concluding that the issue raised in the prior appeal was unworthy of a petition for certiorari. The rationale underlying the work product doctrine is that no attorney or other representative of a party can perform his function in the adversary system if he fears that everything he puts in writing may be disclosed to present or future opponents. As the court of appeals held on the prior appeal, "the rationale is scarcely less applicable to a case which has been closed than to one which is still being contested." Petition for Certiorari, at A72.

[6] In place of the required showing, petitioners advance the theory that the opinion work product at issue here consists of "operative facts." This theory ignores the distinction between the two sentences of Rule 26(b)(3) and would, as the court of appeals pointed out, require discovery of opinion work product merely upon a claim that opinions are relevant.

Therefore, affirmance of the order below would be required whether or not this Court agrees with the court of appeals' view of the law. *E.g., Dandridge* v. *Williams*, 397 U.S. 471, 475-476 & n.6 (1970); *Walling* v. *General Industries Co.*, 330 U.S. 545, 547 & n.5 (1947); *Swarb* v. *Lennox*, 405 U.S. 191, 202 (1972) (White, J., concurring). The existence of an independent ground for affirmance requires denial of the petition for certiorari. Cf. *The Monrosa* v. *Carbon Black, Inc.*, 359 U.S. 180, 183-184 (1959).

Conclusion

For the reasons stated, the petition for a writ of certiorari should be denied.

Respectfully submitted.

Jay Greenfield,
Counsel for Respondent.

Robert S. Smith,
Steven Finell,
Of Counsel.

March 5, 1975